

No. 15,986 ✓

IN THE

**United States Court of Appeals  
For the Ninth Circuit**

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ELRICK RIM COMPANY, a copartnership  
consisting of M. C. Elrick and M. B.  
Champlin,

*Appellant,*

vs.

READING TIRE MACHINERY Co., INC., a cor-  
poration, and RALPH R. READING, an  
individual,

*Appellees.*

**BRIEF ON BEHALF OF APPELLANT,  
ELRICK RIM COMPANY, A COPARTNERSHIP CONSISTING OF  
M. C. ELRICK AND M. B. CHAMPLIN.**

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SEP - 5 1958

PAUL P. O'BRIEN,



## Subject Index

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	Page
Statement of the pleadings and jurisdiction .....	1
The parties .....	3
Concise statement of the case .....	3
Assignment of errors .....	9
The claims of the patent in suit do not define a patentable invention .....	11
Appellant, Ralph R. Reading, by using an old and well-known paint spray pot in the customary manner to spray rubber cement, did not make a patentable invention....	20
The claims of the Reading patent do not particularly point out and distinctly claim an identifiable invention as required by statute .....	25
1. The claims fail to define and point out the only use for the invention .....	27
2. The claims fail to define and point out the method of forming the "emulsion" called for and the volume of air said emulsion is to be mixed with .....	28
3. The claims do not distinctly point out and distinctly claim the feature of the invention that prevents the settling out of the solid components of the cement..	29
4. The production of a non-explosive spray is not particularly pointed out or distinctly claimed .....	30
5. The pressure of the independent stream of air is not specified in the claims although critical .....	33
The District Court erred in not holding the claims of the patent in suit and each of them invalid in law in that said claims define nothing more than the function of a machine .....	36
Anticipation .....	41
Prior uses .....	41
Prior patents .....	46
Shelburne Patent No. 1,710,435 .....	47

	Page
Gradolph Patent No. 1,318,863 .....	49
McLean et al. No. 1,395,965 .....	50
Cahill Patent No. 2,758,037 .....	51
Reading did nothing more than exercise mechanical skill in selecting an old device as a means to practice his process	53
Non-infringement .....	57
a) Elrick Rim Company does not infringe the patent in suit because Elrick Rim Company neither forms nor sprays an emulsion of air in rubber cement, nor forms or sprays a rubber cement saturated with air as called for by the claims of the patent in suit....	57
b) The claims of the Reading patent calls for an "emulsion" and the specification must be examined to determine the proper meaning of this term .....	63
The District Court erred in awarding attorneys' fees to appellees .....	66
The findings of fact entered herein by the District Court are clearly erroneous .....	71
Appellees, by wholesale notification of infringement of appellant's customers was guilty of unfair competition..	76
Conclusion .....	78

## Table of Authorities Cited

Cases	Pages
American Lava Co. et al. v. Steward et al., 155 F. 731....	37
Aro Equipment Corporation v. Herring-Wissler Co. (C.A. 9, 1936), 84 F. 2d 619 .....	56
Bailey v. Sears, Roebuck & Co., 115 F. 2d 904 (C.A. 9, 1940) .....	56
Beacon Theatres v. Westover, 252 F. 2d 864 .....	67, 78
Boyden Power-Brake Co. et al. v. Westinghouse et al., 18 S. Ct. 707 .....	36
Delco Chemicals, Inc. v. Cee-Bee Chemical Co., Inc., 157 F. Supp. 583 .....	22, 56
Dittgen v. Racine Paper Goods Co., 164 F. 85 .....	77
Electric Storage Battery Co. v. Shimadzu et al., 307 U.S. 5, 59 S. Ct. 675 .....	44
Elliott Core Drilling Co. v. Smith, 50 F. 2d 813 .....	12
Fowler v. Vimcar Sales Company, 216 F. 2d 263 .....	55
Gomez, et al. v. Granat Bros., et al., 177 F. 2d 266 (C.A. 9) .....	16, 46, 56
Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U.S. 271, 69 S. Ct. 535 .....	34
Interstate Folding Box Co. v. Empire Box Corporation, 68 F. 2d 500 .....	37
Jacuzzi Bros., Inc. v. Berkeley Pump Co., 9 Cir., 191 F. 2d 632 .....	46, 56
Knapp v. Morss, 150 U.S. 221 .....	53
Kugelman v. Sketchley, 133 F. 2d 426 .....	63
Kwikset Locks, Inc. v. Hillgren, 210 F. 483 .....	60
Lanyon v. M. H. Detrick Co., 85 F. 2d 875 .....	64
Lempeo Products, Inc. v. Timken-Detroit Axle Co., 110 F. 2d 307 (C.A. 6) .....	41
Lovell Manufacturing Co. v. Cary, 147 U.S. 623, 13 S. Ct. 472 .....	23
Ludlow Manufacturing & Sales Co. v. Dolphin Jute Mills, Inc., 50 F. Supp. 395, Per Curiam Affirmance, 145 F. 2d 471 (C.C.A. 3) .....	39

	Pages
MacDougald Const. Co. v. Finley, 38 F. 2d 809 (C.C.A. 5)	47
McRoskey v. Braun Mattress Co., 107 F. 2d 143 .....	65
Miller v. Eagle Mfg. Co., 151 U.S. 186 .....	53
Oriental Foods, Inc. v. Chun King Sales, Inc., 244 F. 2d 909 .....	13
Palmer v. Kaye, 185 F. 2d 330 (C.A. 9) .....	17
Park-In Theatres v. Perkins, 190 F. 2d 137 .....	68
Pennsylvania R. Co. v. Locomotive Engine Safety Truck Co., 4 S. Ct. 220 .....	51
Peters v. Active Mfg. Co., 129 U.S. 530 .....	53
Pierce v. Muehleisen, 226 F. 2d 200 .....	19, 25, 52, 56
Ralph F. Stallman v. Casey Bearing Company, Inc., 144 F. Supp. 927 (U.S.D.C. N.D. California, S.D. 1956) .....	52
Ray, et al. v. Bunting Iron Works, 4 F. 2d 214 (C.A. 9, 1925) .....	56
R. G. Le Tourneau, Inc. v. Gar Wood Industries, Inc., 151 F. 2d 432 (C.A. 9) .....	24
Schick Service, Inc. et al. v. Jones, 173 F. 2d 969 .....	17
Schnitzer et al. v. California Corrugated Culvert Co. et al., 140 F. 2d 275 .....	64
Sinclair & Carroll Co., Inc., v. Interchemical Corporation, 325 U.S. 331, 65 S. Ct. 1143 .....	18, 24
Stauffer v. Slenderella Systems of California, Inc., 254 F. 2d 127 .....	41
Syracuse v. Paris, 9 Cir., 234 F. 2d 65 .....	46
United States v. Patterson et al., 205 F. 292 .....	77
Winslow Engineering Company v. Smith, 223 F. 2d 438 ...	34

### Statutes

28 U. S. Code, Section 1291 .....	2
28 U. S. Code, Section 2201 (Federal Declaratory Judg- ments Act) .....	1, 2, 3, 9
35 U.S. Code 112 .....	25, 79

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**STATEMENT OF THE PLEADINGS  
AND JURISDICTION.**

This action was commenced in the United States District Court for the Southern District of California, Central Division, by the filing of a Complaint under the provisions of the Declaratory Judgments Act (28 U.S.C., Section 2201), wherein it was prayed that United States Letters Patent No. 2,721,148 (R. 703) owned by appellee,



Ralph R. Reading, be declared invalid and not infringed by the use of a spray device and the process performed by its use that was manufactured, sold and used by appellant. Further, appellant prayed that Reading Tire Machinery Co., Inc. and Ralph R. Reading be enjoined from, among other things, threatening any of appellant's customers, distributors, dealers or users or prospective customers, distributors, dealers or users of appellant's device with patent infringement because of the use of any spray device manufactured or sold by appellant.

Appellees filed an Answer and Counterclaim for Patent Infringement (R. 19), and appellant filed an Answer to Counterclaim (R. 25).

The United States District Court had jurisdiction under the Federal Declaratory Judgments Act, Title 28, U. S. Code, Section 2201, and the patent laws of the United States.

The District Court found in favor of appellees, holding the patent valid and infringed by appellant and entered its Findings Of Fact, Conclusions Of Law and Judgment on December 24, 1957. On January 20, 1958, within thirty (30) days following the entry of the Judgment, appellant filed its Notice of Appeal (R. 66), an Appeal Bond (R. 68), its Designation of Contents of Record on Appeal and its Concise Statement Of Points On Which Plaintiff and Counterdefendant Intends To Rely On Appeal (R. 699).

Jurisdiction of this Court is invoked under 28 U. S. Code, Section 1291.



**THE PARTIES.**

The appellant, Elrick Rim Company, was a copartnership consisting of M. C. Elrick and M. B. Champlin, both residents of Hayward, California, having its principal place of business at Hayward, California. Since the filing of the Complaint herein, said Elrick Rim Company has become a California corporation, having its principal place of business at Hayward, California.

Appellee, Reading Tire Machinery Co., Inc., is a California corporation, having its principal place of business at Hawthorne, California. Appellee, Ralph R. Reading, is an individual residing at Hawthorne, California, and is the patentee and owner of Letters Patent No. 2,721,148. Reading Tire Machinery Co., Inc., is the exclusive licensee of said Letters Patent under an oral license.

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**CONCISE STATEMENT OF THE CASE.**

This is a suit for patent infringement involving Reading Letters Patent No. 2,721,148 which covers a process for spray painting rubber cement onto a surface.

This suit originated under the Declaratory Judgments Act (28 U. S. Code, Section 2201), wherein appellant, after receiving a notice of infringement from appellees (R. 863), sought a declaration that said Letters Patent No. 2,721,148 was invalid and not infringed.

The process of spray painting of the patent in suit is employed in the retreading of truck and automobile tires. When a tire is to be retreaded, the first step is to buff off the old tread of the tire. When this step is completed,

the tread surface of the tire is fairly rough. The next step in retreading is to coat this buffed surface of the tire with rubber cement. The purpose of this step of coating rubber cement on the tire is merely to apply to the surface of a tire a cement that will hold the camelback or tread rubber on the tire carcass during the remaining steps of the retreading process. Camelback is then applied to this coated surface. An inner tube is then put into the casing and a so-called curing rim is also placed inside the casing. The tire is then put into a curing mold, inflated to about 130 pounds pressure, and heat to about 300° F. is applied to this mold for about one hour and to the camelback until the camelback is cured.<sup>1</sup>

The process of the Reading patent in suit is employed to spray rubber cement onto the buffed surface of the tire carcass for holding the camelback in place during the succeeding steps of the retreading process.

Appellant manufactured, sold and used an old and well-known pressure paint spray pot device for spraying rubber cement. Appellant placed rubber cement in the old spray pot and then said spray pot was used in this normal operating manner to spray the rubber cement onto the buffed surface of the tire carcass. This old established process of spray painting employed, resulting from the ordinary use of this old paint spray pot, is the process that is here charged to infringe the Reading patent in suit.

Appellee Ralph R. Reading, after securing his patent No. 2,721,148 on October 18, 1955, sent a notice of infringe-

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<sup>1</sup>These pressures and temperatures are used in retreading tires for passenger cars; on truck tires higher pressures are employed.

ment to appellant, as well as to many of appellant's dealers and users, advising them that the use of the spray equipment manufactured and sold by appellant was an infringement of said Patent No. 2,721,148. Shortly after this wholesale notice of infringement to appellant's customers, appellee, Reading Tire Machinery Co., Inc., published an announcement in the Tire, Battery & Accessory News of January 1956, giving the trade in general notice of infringement (R. 17). This trade magazine is read by practically every one in the retreading industry (R. 231), and this advertisement resulted in injury to appellant's business (R. 246-247).

A justiciable controversy existing between appellant and appellees, appellant filed its Complaint under the Declaratory Judgments Act to resolve said controversy.

Long prior to the filing by appellee, Ralph R. Reading, of an application for Letters Patent, the process of spraying rubber cement on the buffed surface of a tire carcass, during the retreading of tires, had been publicly used. These prior public uses were substantially identical to the process of the Reading patent and were for the identical purpose. Said prior uses were employed by W. S. Cahill and D. S. Hartman, both of Danville, Virginia, witness on behalf of appellant (R. 613 and 670), and also by appellee, Ralph R. Reading, himself (R. 363).

W. S. Cahill, as early as January 1953, publicly and commercially used a process for spraying rubber cement that was substantially identical to the process of the patent in suit. Thereafter, on June 17, 1953, Cahill filed an application for Letters Patent on his process and apparatus, and Letters Patent No. 2,758,037 (R. 769) was

issued therefor on August 7, 1956. Said Cahill patent is pleaded as prior art (R. 30-31) and relied upon herein as an anticipatory reference.

D. S. Hartman, of Danville, Virginia, secured a Cahill spray device on February 7, 1953 (R. 625) and has used this device in practicing a process of spraying rubber cement on tires ever since (R. 677). Cahill also sold these devices for practicing a method of spraying rubber cement prior to a year before Reading filed his application for Letters Patent (R. 627-628, Exs. 11 and 12, R. 837-839).

Appellee, Ralph R. Reading, admitted on cross-examination (R. 364) that he used substantially the identical process in his tire retreading shop from the end of 1951 to October 1953 (R. 347-348), and during this period he sold, in the regular course of his business, at least 300 to 400 tires a month wherein said process was employed (R. 352-353). Thus, there were between 6600 and 8800 tires retreaded and sold by Mr. Reading during this period wherein rubber cement was applied to the tire by this prior spray process.

In addition to the prior public uses of Cahill, Hartman and Reading and the prior Cahill patent, the spray painting devices disclosed in the prior art patents to Gradolph No. 1,318,863 (R. 753, Ex. 4), McLean, et al., No. 1,395,965 (R. 759, Ex. 4) and Shelburne No. 1,710,435 (R. 765, Ex. 4), have a normal operating process of spray painting identical to the Reading patented process. It was admitted by appellees' expert, on cross-examination (R. 427-431), that if rubber cement and solvent were placed in the tanks of the spray devices disclosed in said prior art



patents to Shelburne (R. 765) and Gradolph (R. 753), and these spray devices operated in accordance with the normal operating process disclosed in said patents, the process of the Reading patent in suit would be employed.

The trial court, in reaching the decision that the Reading patent in suit was valid, completely disregarded the above noted evidence respecting the prior uses of Cahill, Hartman and Reading, because in its Findings Of Fact (Finding IV) the Court found that the method employed to place rubber cement on the buffed surface of tire carcasses, immediately prior to the invention of the Reading patent in suit, was by painting a thick coating of rubber cement on the tire with a brush. This Finding by the District Court is completely contrary to the evidence and is clearly erroneous.

The evidence also establishes that appellant's process is not an infringement of the process of the Reading patent in suit because the only teaching of the Reading patent is that the cement in the tank of the Reading device is subjected to an initial pressure of at least 40 pounds to the square inch and thereafter reducing this pressure to an application pressure of 15 pounds to the square inch (Reading patent Ex. 1, Col. 4, lines 5 to 27, R. 706, Reading cross-examination R. 362). This initial pressure of 40 pounds is important, according to the teachings of the Reading patent, because by this high initial pressure and subsequent reduction of pressure, the rubber cement in the tank becomes emulsified or, as testified to, becomes a solution that is supersaturated with small air bubbles (Petersen, R. 512-513; Stringfield, R. 410).

Appellant's process does not employ a method wherein there is an initial pressure of 40 pounds per square inch and then a reduction of that pressure to 15 pounds per square inch but, on the contrary, as admitted by appellees' expert, appellant, at no time in its process uses a pressure of over 10 pounds per square inch (R. 435-436). The only evidence is that the initial pressure and the normal operating or application pressure employed in appellant's process is a constant, uniform pressure of 10 pounds per square inch. The testimony establishes that by using only a pressure of 10 pounds per square inch, the rubber cement in the tank of appellant's device is not emulsified (Wolk, R. 107, Stringfield, R. 444 and Petersen R. 512), and does not become a solution supersaturated with air bubbles (Petersen, R. 512). Therefore, with the omission in appellant's process of the step of charging the rubber in the tank with an initial pressure of 40 pounds and thereafter reducing the pressure to 15 pounds, there can be no infringement of the Reading patent in suit.

The evidence clearly establishes that spraying rubber cement is old. Therefore, if appellant's process of spraying rubber cement is an infringement of the patent in suit, then the process resulting from the normal operation of the devices disclosed in the prior art patents to Shelburne No. 1,710,435 and to Gradolph No. 1,318,863, and the prior uses of Cahill and Hartman, would also be an infringement of the claims of the Reading patent in suit and, Reading therefore, is invalid and under the old axiom "That which infringes if later anticipates if earlier."

In addition to awarding damages, an injunction and costs to appellees, the District Court awarded to appellees attorneys' fees in the amount of Seven Thousand Five Hundred Dollars (\$7500.00). This award was made even though appellees precipitated this suit, under the provisions of the Declaratory Judgments Act (28 U.S.C. 2201), by serving a notice of infringement on appellant. The only thing appellant did, after receiving notice of infringement, was to proceed in the normal manner prescribed by said Declaratory Judgments Act and file suit to settle the controversy. The District Judge, by awarding attorneys' fees, penalizes appellant for following a procedure prescribed by statute for the protection of its rights.

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#### **ASSIGNMENT OF ERRORS.**

1. The District Court erred in not holding the claims of the patent in suit and each of them invalid in law in that said claims do not define a patentable invention.

2. The District Court erred in not holding the claims of the patent in suit and each of them invalid in law in that only mechanical skill was required to produce the process defined in said claims.

3. The District Court erred in not holding the claims of the patent in suit and each of them invalid in law in that the process defined in said claims was anticipated by the prior art.

4. The District Court erred in not holding that Reading did not invent a new "process" but merely followed the teachings of the prior art.



5. The District Court erred in not holding the claims of the patent in suit and each of them invalid in law in that said claims define nothing more than the function of a machine.

6. The District Court erred in not holding the claims of the patent in suit and each of them invalid in law because of prior public use.

7. The District Court erred in not holding the claims of the patent in suit and each of them invalid in law because of prior knowledge.

8. The District Court erred in not holding the claims of the patent in suit and each of them invalid in law in that they do not particularly point out and distinctly claim an identifiable invention as required by the statutes and law of the United States.

9. The District Court erred in holding that the appellant infringed each of the claims of the patent in suit.

10. The District Court erred in holding that the appellant infringed each of the claims of the patent in suit by manufacturing, selling and using spray devices in that the process employed in the use of the appellant's spray device is substantially different than the process described and claimed in the patent in suit and is not the equivalent thereof.

11. The District Court erred in holding that the appellant infringed each of the claims of the patent in suit because the spray process practiced by it follows the teachings of the prior art and not the patent in suit, and, consequently, cannot infringe the claims of the patent in suit.

12. The District Court erred in holding that the appellant infringed each of the claims of the patent in suit because if said claims are construed to include the process practiced by the said appellant, then the claims also include the prior art and are invalid.

13. The District Court erred in not holding that the process described and claimed in the patent in suit must be limited to the precise steps described in the specification of said patent and the equivalents thereof, and when so interpreted, the accused process is not infringement thereof.

14. The District Court erred in awarding attorneys' fees to appellees.

15. The District Court erred in awarding the sum of Seven Thousand Five Hundred Dollars (\$7500.00) to appellees as attorneys' fees in that, under the circumstances attending the action, such an award is excessive and unreasonable.

16. The Findings of Fact made and entered herein by the District Court are not in accordance with the facts as established by the evidence and are clearly erroneous.

17. The District Court erred in refusing relief to appellant on the grounds that appellees were guilty of unfair competition.

18. The District Court erred in dismissing the Complaint.

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**THE CLAIMS OF THE PATENT IN SUIT DO NOT  
DEFINE A PATENTABLE INVENTION.**

Does Reading's invention measure up to the standard of invention as it is written into the Constitution and

applied by the Supreme Court and by this Court? It is submitted that it does not.

Simply stated, the Reading invention covers nothing more than an old process of spray painting, wherein the material sprayed is a mixture of rubber cement and a petroleum solvent and has air entrained in said mixture; mixing said cement, solvent and air with an independent stream of air by means of an ordinary spray gun and directing the resultant mixture onto a surface to form a thin uniform coating.

This is nothing more than an old process of spray painting, used for years and years in the spray painting art. The evidence establishes that the process of spraying rubber cement was old long before Reading developed his patented process. Such old processes are found in the Cahill Patent No. 2,758,137 (Ex. 4, R. 769), the Cahill and Hartman prior uses (R. 613 to 695) and the Reading prior use (R. 363). The evidence also establishes that in these prior processes the mixture of rubber cement and solvent had air entrained therein, due to the absorption of air by the cement and to the air pressure used in the spray pot employed (R. 354, 451). Thus, the resulting mixture of cement sprayed in the prior art was substantially identical to that of the patented process. The possible difference is a difference in degree only and is not an invention. This Court has so held in the case of *Elliott Core Drilling Co. v. Smith*, 50 F. 2d 813, 816, where it said the following:

“A mere carrying forward of the original thought, a change only in form, proportions, or degree, doing the same thing in the same way, by substantially the

same means, with better results, is not such an invention as will sustain a patent. \* \* \*”

Just what did Reading do over and above this prior art to warrant a patent? The answer to this is that Reading actually did nothing more than select from the prior art an old paint spray pot that employed an air inlet tube that extended into the pot with the open end of said air inlet tube adjacent the bottom of the pot, and employ the method resulting from the use of this pot to spray rubber cement. There was nothing new in such a device or in the method of use of such a device because the Shelburne Patent No. 1,710,435 of 1929 (Ex. 4, R. 765) discloses a paint spray pot identical in construction, mode of operation and result as that employed in the Reading process. It can hardly be said that this act of selection of an old well-known spray pot measures up to the standard of invention set by the Constitution and the Courts.

This Court in its recent decision in the case of *Oriental Foods, Inc. v. Chun King Sales, Inc.*, 244 F. 2d 909, 913, had occasion to review the standard of invention necessary for valid patent protection in connection with a process. In that case this Court said:

“The mere fact that the device may make the wrapping of the cans easier to accomplish does not, in and of itself justify a claim of invention. As the District of Columbia Circuit held in a recent decision:

‘A mere advance in efficiency and utility is not enough to convert a non-inventive aggregation into a patentable combination.’;

citing the *Kwikset Locks, Inc., v. Hillgren* case, 1954, 210 F. 2d 483 of this Circuit.

The standard of invention is written into the Constitution. The Supreme Court has held that the determination by the trial court of the question of invention need not be accorded the respect given ordinary findings of fact. *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, supra, concurring opinion, 340 U.S. at pages 155-156, 71 S. Ct. at pages 131-132. See also *Crest Specialty v. Trager*, 341 U.S. 912, 71 S. Ct. 733, 95 L. Ed. 1349, where the Supreme Court, by per curiam opinion, summarily held invalid a patent previously upheld by the district and circuit courts. This Court has only recently reaffirmed its long held position that the question of novelty and invention is one of fact as to which the conventional clearly erroneous test is applicable. *Hall v. Wright*, 9 Cir., 240 F. 2d 787. We are not disposed to modify our statement of the test applicable on appellate review. This is not a case involving disputed evidence or the credibility of witnesses. The prime evidence is documentary, and is before this Court. Under such circumstances we have a greater discretion in deciding the validity of the patent in question. *Sales Affiliates, Inc., v. National Mineral Co.*, 7 Cir., 172 F. 2d 608. We believe that the patent involved in the instant cause rightfully belongs, to use the words of Justice Douglas, among the 'list of incredible patents which the Patent Office has spawned.' 340 U.S. at page 158, 71 S. Ct. at page 133. It is a trifling device at best. It makes no substantial contribution to the advancement of the arts. And certainly it lacks that 'flash of genius' that the patent laws seek, if not require.

The words of Justice Bradley in *Atlantic Works v. Brady*, 107 U.S. 192, 200, 2 S. Ct. 225, 231, 27 L. Ed. 438, are especially apt:



‘It was never the object of those laws to grant a monopoly for every trifling device, every shadow of a shade of an idea, which would naturally and spontaneously occur to any skilled mechanic or operator in the ordinary progress of manufacturers. Such an indiscriminate creation of exclusive privileges tends rather to obstruct than to stimulate invention. It creates a class of speculative schemers who make it their business to watch the advancing wave of improvement, and gather its foam in the form of patented monopolies, which enable them to lay a heavy tax upon the industry of the country, without contributing anything to the real advancement of the arts. It embarrasses the honest pursuit of business with fears and apprehensions of concealed liens and unknown liabilities to lawsuits and vexatious accountings for profits made in good faith.’

As Justice Douglas stated in his concurring opinion in the Great Atlantic & Pacific Tea Co. case,

‘The attempts through the years to get a broader, looser conception of patents than the Constitution contemplates have been persistent. The Patent Office, like most administrative agencies, has looked with favor on the opportunity which the exercise of discretion affords to expand its own jurisdiction. And so it has placed a host of gadgets under the armour of patents—gadgets that obviously have had no place in the constitutional scheme of advancing scientific knowledge.

\* \* \* \* \*

‘The fact that a patent as flimsy and as spurious as this one has to be brought all the way to this court to be declared invalid dramatically illustrates how far our patent system frequently departs from

the constitutional standards which are supposed to govern.' 340 U.S. at pages 156, 158, 71 S. Ct. at page 132.

We conclude that the Paulucci patent cannot be sustained. Placed aside the Constitutional criteria for invention, this device does not measure up. In coming to this conclusion we follow *Kwikset Locks, Inc., v. Hillgren, supra*, having in mind *Coleman Company v. Holly Mfg. Co., 9 Cir., 1956, 233 F 2d 71, 80.*'

Another decision of this Court that is in point is *Gomez, et al. v. Granat Bros., et al., 177 F. 2d 266, 268 (C.A. 9)*, wherein the Court said:

“Granat did not invent nor discover the finger ring ensemble with interlocking relationship; neither did he invent nor discover the dovetail joint. He used the dove-tail joint as a means of interlocking the two rings. As said by the court in *Dow Chemical Co. v. Halliburton Oil Well Cementing Co., supra*, (324 U.S. 320, 65 S. Ct. 650). ‘He who is merely the first to utilize the existing fund of public knowledge for new and obvious purposes must be satisfied with whatever fame, personal satisfaction or commercial success he may be able to achieve. Patent monopolies, with all their significant economic and social consequences, are not reserved for those who contribute so insubstantially to that fund of public knowledge.’”

Reviewing the present case in the light of the *Gomez* decision, Reading did not invent nor discover the spraying of rubber cement; neither did he invent nor discover the process of spraying. He used the process inherent in the spray pot disclosed in the Shelburne patent as the means of spraying rubber cement. Both the process inherent in



the operation of the spray pot of Shelburne and the spraying of rubber cement were in the public domain. Reading was merely utilizing the existing fund of public knowledge for an obvious purpose. *Patent monopolies, with all their significant economic and social consequences, are not reserved for those who contribute so insubstantially to that fund of public knowledge.*<sup>2</sup>

Another case in which the Court of Appeals for the Ninth Circuit ruled that an invention must be something more than new and useful in order to be subject to patent protection is *Schick Service, Inc. et al. v. Jones*, 173 F. 2d 969, 974, where the Court said:

“\* \* \* Even though the functions performed by the combination be new and useful, this does not make the device patentable, for it must also be invention and/or discovery. There must be ingenuity over and above mechanical skill. These features have been used in a similar fashion in earlier patented devices. \* \* \*”

See also the case of *Palmer v. Kaye*, 185 F. 2d 330, 332 (C.A. 9), where this Court said:

“We think the improvement is one within the rule stated in *Cuno Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 90, 62 S. Ct. 37, 40, 86 L. Ed. 58, as follows: ‘We may concede that the functions performed by Mead’s combination were new and useful. But that does not necessarily make the device patentable. Under the statute, 35 U.S.C. § 31, R.S. § 4886, the device must not only be “new and useful”, it must also be an “invention” or “discovery”. *Thompson v. Boisselier*, 114 U.S. 1, 11, 5 S. Ct. 1042, 1047, 29 L.

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<sup>2</sup>All emphasis ours unless otherwise noted.

Ed. 76. Since Hotchkiss's Ex'x. v. Greenwood, 11 How. 248, 267, 13 L. Ed. 683, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art \* \* \*. That is to say the new device, however useful it may be, must reveal the flash of creative genius not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain.'

“We think that what Palmer did here was not invention, but a mere exercise of the skill of the calling, and an advance plainly indicated by the prior art.”

Another expression of the rule by the Supreme Court is found in *Sinclair & Carroll Co., Inc., v. Interchemical Corporation*, 325 U.S. 331, 65 S. Ct. 1143-1145, where the Court said:

“A long line of cases has held it to be an essential requirement for the validity of a patent that the subject-matter display ‘invention’, ‘more ingenuity \* \* \* than the work of a mechanic skilled in the art.’ *Hicks v. Kelsey*, 18 Wall. 670, 21 L.Ed. 852; *Slawson v. Grand Street R. Co.*, 107 U.S. 649, 2 S. Ct. 663, 27 L. Ed. 576; *Phillips v. Detroit*, 111 U.S. 604, 4 S. Ct. 580, 28 L. Ed. 532; *Morris v. McMillin*, 112 U.S. 244, 5 S. Ct. 218, 28 L. Ed. 702; *Saranac Automatic Machine Corp. v. Wirebounds Patents Co.*, 282 U.S. 704, 51 S. Ct. 232, 75 L. Ed. 634; *Honolulu Oil Corp. v. Halliburton*, 306 U.S. 550, 59 S. Ct. 662, 83 L. Ed. 980; *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 90, 62 S. Ct. 37, 40, 86 L. Ed. 58. This test is often difficult to apply; but its purpose is clear. Under this test, some substan-

tial innovation is necessary, an innovation for which society is truly indebted to the efforts of the patentee. Whether or not those efforts are of a special kind does not concern us. The primary purpose of our patent system is not reward of the individual but the advancement of the arts and sciences. Its inducement is directed to disclosure of advances in knowledge which will be beneficial to society; it is not a certificate of merit, but an incentive to disclosure. See *Hartford Empire Co. v. United States*, 323 U.S. 386, 65 S. Ct. 373, at page 395.”

All Reading did was to take the device of Fig. 3 of the Shelburne patent, place therein rubber cement and solvent and then employ said device in its ordinary method of operation. It is submitted that this is not invention. To establish this we apply the well-known rule expressed by this Court in the case of *Pierce v. Muehleisen*, 226 F. 2d 200, 204, where the following was said:

“We do no more than recite a well established rule of law when we say the application of an old process to analogous material of foreseeably similar character is not a sufficient contribution to the science to justify the award of a patent monopoly. It is only the achievement of the inventive faculty, as opposed to the product of the exercise of ordinary professional skill, that entitles the researcher to a patent. 35 U.S.C.A. § 103, *Mandel Bros. v. Wallace*, 335 U.S. 291, 69 S. Ct. 73, 93 L. Ed. 12; *General Electric Co. v. Wabash Appliance Corp.*, 304 U.S. 364, 58 S. Ct. 899, 82 L. Ed. 1402; see also, *Standard Brands v. National Grain Yeast Corp.*, 308 U.S. 34, 60 S. Ct. 27, 84 L. Ed. 17; *Paramount Publix Corp. v. American Tri-Ergon Corp.*, 294 U.S. 464, 55 S. Ct. 449, 79 L. Ed. 997; and, *Pennsylvania Railroad Co. v. Loco-*

motive Engineer Safety Truck Co., 110 U.S. 490, 4 S. Ct. 220, 28 L. Ed. 222.”

It is obvious that Reading did not make an invention subject to patent protection under the rules as stated by the statutes of the United States or the interpretation of said statutes by the Courts.

The Reading patent, if sustained, will withdraw from the public domain the use of spray processes that have long been known and used by the public, spray processes and devices that have been previously used long prior to Reading. Such a result is not the intent nor is it the purpose of the patent laws. The Reading patent just does not measure up to the standard of invention.

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**APPELLANT, RALPH R. READING, BY USING AN OLD AND WELL-KNOWN PAINT SPRAY POT IN THE CUSTOMARY MANNER TO SPRAY RUBBER CEMENT, DID NOT MAKE A PATENTABLE INVENTION.**

The Reading patent was not the first disclosure of spraying rubber cement on a tire carcass during the retreading process to hold the camelback in place. Reading did not file an application for Letters Patent until July 23, 1954, which was long after rubber cement had first been sprayed on tire carcasses to hold the camelback in place. The evidence establishes that W. S. Cahill, of Danville, Virginia, developed a method of spraying tire carcasses with rubber cement during the retreading process as early as January 1953 (R. 615). Cahill, in addition to using a spray of rubber cement, employed oscillating brushes to assist in spreading the rubber cement on the

tire carcass (R. 619). Cahill gave one of his devices for spraying rubber cement to Hartman on February 7, 1953 (R. 625), and the evidence establishes that ever since said date Hartman has employed this machine in spraying tire carcasses with rubber cement during the retreading process (R. 675).

Exhibit 16 establishes that from February 7, 1953, to approximately July 23, 1954, Hartman, in the regular course of his business, employed this Cahill spray method on some 4,658 tires (R. 676). Both Cahill and Hartman testified that the tires retreaded by this Cahill process were satisfactory and also that the benefits derived from the use of this process were identical to those claimed by Reading (R. 646-647 and 688-689). The only difference between the Cahill method of spraying and the claims of the Reading patent here involved is that Cahill does not emulsify the rubber cement as emulsification as defined by Reading. By the same token, Elrick Rim Company does not emulsify its rubber cement in the practice of the Elrick process of spraying rubber cement.

Mr. Reading, in his testimony, admitted that he began the use of spraying rubber cement on tire carcasses during the retreading process during the latter part of 1951 (R. 350). The only difference between the spray process practiced by Reading in 1951 and the claims of the Reading patent here in suit is that in the early Reading process the rubber cement was not emulsified as defined by the Reading patent (R. 364). Mr. Reading used his spray process from the latter part of 1951 to September 1953 (R. 352). During this time Mr. Reading used this spray process in the regular course of his tire retreading busi-



ness and retreaded between 300 and 400 tires a month by use of this process (R. 352-353).

The following statement from the case of *Delco Chemicals, Inc. v. Cee-Bee Chemical Co., Inc.*, 157 F. Supp. 583, 590, wherein the Court there quoted from a 9th Circuit case, is apropos of these prior uses above discussed:

“Even if it be said that there appears no ‘strict anticipation’ of the patent in suit, and that the method involves some novelty, it nonetheless lacks invention. As Judge Fee stated for the Court in *Stauffer v. Slenderella Systems of California, Inc.*, 9 Cir., 1957, ..... F. 2d .....: ‘The advances in the prior art may be such that, although there is no strict anticipation and even though the \* \* \* [methods] involved may not be similar, a trained mechanic would, if presented with the problem, solve it without difficulty.’ ”

This so-called emulsification is not new because the Shelburne patent discloses a device that is identical in construction, mode of operation and resulting process of use to the Elrick device. The Elrick method here charged to be an infringement is a method that would be employed in the normal method of operating the Shelburne device. Therefore, at the time Reading applied for a patent on his process, there was nothing left for him to invent with respect to said process because it was old to spray rubber cement on tire carcasses, and it was old to emulsify or agitate by passing air through a solution contained in a paint spray pot and then spray said solution onto a surface.

Mr. Stringfield, expert for appellees, had to admit on cross-examination that if rubber cement were placed into

the tank of the Shelburne patent and the Shelburne device operated in the method disclosed in said patent, that one, by adjustment of pressures, would be practicing the Reading process (R. 427-430). Certainly, it does not amount to invention to substitute in a paint spray pot rubber cement for paint and to adjust pressures. Any mechanic, in using any spray pot, adjusts the pressures of air employed.

The alleged invention made by Reading does not measure up to the tests of invention as stated by the Supreme Court and by this Court.

The Supreme Court in the case of *Lovell Manufacturing Co. v. Cary*, 147 U.S. 623, 13 S.Ct. 472, 476, said:

“\* \* \* But it does not amount to invention to discover that an old process is better in its results, when applied to a new working, than would have been expected; the difference between its prior working and the new working being only one of degree, and not one of kind. It has been often held that the mere fact that one who uses a patented process finds it applicable to more extended use than has been perceived by the patentee is not a defense to a charge of infringement. It follows necessarily that the public cannot be deprived of an old process because some one has discovered that it is capable of producing a better result, or has a wider range of use than was before known.

In *Smith v. Nichols*, 21 Wall. 112, it was held that a mere carrying forward, or new or more extended application, of the original thought; a change only in form, proportions, or degree; the substitution of equivalents; doing substantially the same thing in the same way, by substantially the same means, with bet-



ter results,—was not such invention as would sustain a patent; and in *Roberts v. Ryer*, 91 U.S. 150, it was held that it was no new invention to use an old machine for a new purpose, and that the inventor of a machine was entitled to the benefit of all the uses to which it could be put, no matter whether he had conceived the idea of the use or not.”

See also:

*Sinclair & Carroll Co., Inc. v. Interchemical Corporation*, 325 U.S. 327, 65 S. Ct. 1143, 1145.

This Court of Appeals in the case of *R. G. Le Tourneau, Inc. v. Gar Wood Industries, Inc.*, 151 F. 2d 432, 434 (C.A. 9), said:

“As the Supreme Court explained in *Cuno Engineering Corporation v. Automotive Devices Corporation*, 1941, 314 U.S. 84, 90, 62 S. Ct. 37, 40, 86 L. Ed. 58: ‘We may concede that the functions performed by Mead’s combination were new and useful. But that does not necessarily make the device patentable. Under the statute, 35 U.S.C. § 31, 35 U.S.C.A. § 31, R.S. § 4886, the device must not only be “new and useful,” it must also be an “invention” or “discovery.” \* \* \* Since *Hotchkiss v. Greenwood*, 11 How. 248, 267, 13 L. Ed. 683, decided in 1851, it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art.’ The court stated further, 314 U.S. at page 91, 62 S. Ct. at page 41, 86 L. Ed. 58, ‘A new application of an old device may not be patented if the “result claimed as new is the same in character as the original result” \* \* \* even though the new result had not before been contemplated.’”

In considering the application of an old process to an analogous material of foreseeable character, such as Reading did in spraying rubber cement by an old and well-known process, this Court of Appeals in the case of *Pierce v. Muehleisen*, 226 F. 2d 200, 204, said:

“We do no more than recite a well established rule of law when we say the application of an old process to analogous material of foreseeably similar character is not a sufficient contribution to the science to justify the award of a patent monopoly. It is only the achievement of the inventive faculty, as opposed to the product of the exercise of ordinary professional skill, that entitles the researcher to a patent.”

It is submitted that Reading's contribution, merely the selection of a device whose normal use resulted in a method of spray painting, did not amount to invention.



**THE CLAIMS OF THE READING PATENT DO NOT PARTICULARLY POINT OUT AND DISTINCTLY CLAIM AN IDENTIFIABLE INVENTION AS REQUIRED BY STATUTE.**

It is a fundamental rule of patent law that it is the function of the claims of a patent to particularly point out and distinctly claim the invention covered thereby. The pertinent portion of the statute states (35 U.S.C. 112):

“The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and

shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.”

In the light of this statute, let us review the invention made by Reading. If Reading invented anything, he invented a process of forming and thereafter spraying an emulsified rubber cement in the recapping of tires. No other utility for the process is described in his patent nor is any other utility therefor alleged.

The record clearly establishes that the Reading process is made up of the following essential features:

1. It is specifically adapted for use in the recapping of tires (Ex. 1, Col. 1, lines 15-17, R. 705).

2. It requires the forming of an “emulsion” of air in a cement containing an inflammable solvent, said “emulsion” being in the form of a multiplicity of minute air bubbles dispersed in the cement (R. 410). Such an emulsion, according to the patent specification (Ex. 1, Col. 4, lines 5 to 19, R. 706) and the uncontradicted testimony of the witnesses, can only be formed by the use of two stages of pressure in the pressure tank of a spray device; beginning with an initial pressure of 40 pounds per square inch or more followed by the reduction of pressure below the said initial pressure to preferably 10 to 15 pounds per square inch (R. 361-362, 410 and 512). As a result of this two-stage pressure treatment, air dissolved in the cement at the higher pressure is released and forms a

multiplicity of minute air bubbles in the cement at the lower pressure (R. 410).

3. An important feature of the alleged invention is the function of the emulsion in preventing the settling of the solid components of the cement (R. 402-403).

4. Another important feature of the alleged invention is the production of a non-explosive spray through the admixture of the cement-air "emulsion" with a sufficiently large volume of air from an independent stream of air in a mixing zone (R. 294-296).

5. A further important part of the alleged invention is the use of air pressure in the independent stream of air at from 150 to 200 pounds per square inch with a pressure in the tank of 15 pounds per square inch (R. 238, 364).

In analyzing the claims of the Reading patent to determine whether or not these essential elements, limitations and conditions are included therein, it is found that there is a complete absence of a definition of these important features of Reading's invention.

**1. The claims fail to define and point out the only use for the invention.**

The claims do not in any way mention or limit the invention to the specific art to which it is directed; namely, the recapping of tires. There is no question that the Reading process is designed to solve problems existing only in, and peculiar to, the tire recapping art. The claims are not so limited, instead they are drawn broadly to "A method of applying rubber cement . . . onto a surface."

2. The claims fail to define and point out the method of forming the "emulsion" called for and the volume of air said emulsion is to be mixed with.

If Reading can be attributed with any discovery or invention, it is in the formation of the "emulsion" of air in a cement containing an inflammable solvent. This emulsion must be one wherein there is formed a multiplicity of minute air bubbles in the cement. Such an emulsion can *only* be formed by first charging the cement with an air pressure of at least 40 pounds per square inch and then reducing that pressure below 40 pounds per square inch.

The claims (Ex. 1, R. 707) describe the formation of the emulsion in the following manner:

Claim 1: . . . "forming an emulsion of air in the cement in a dispersion zone by introducing said air under pressure into a substantial body of cement maintained in said zone at superatmospheric pressure . . ."

Claim 2: . . . "introducing a quantity of air at superatmospheric pressure into the cement under emulsion conditions to form a stable dispersion of gas and cement under pressure . . ."

Claim 3: . . . "introducing a quantity of air into the cement under conditions to form an emulsion of air in the liquid cement at a pressure in the range of about 5 pounds to about 200 pounds per square inch . . ."

Claim 4: . . . "introducing a quantity of air into the liquid cement under conditions to form an emulsion of air in the cement at a pressure in the range of about 5 pounds to about 200 pounds per square inch . . ."



Not one of the claims refers to any feature suggestive of the method of forming the emulsion; namely, an initial high pressure and then a reduction of that initial pressure,—a critical element of this invention. This is the only element of the invention that distinguished the claimed process from the process used for many years by Reading in the regular course of his retreading business. Thus, the only novel feature of the Reading patented process is not distinctly claimed or particularly pointed out in the claims in suit.

The specification points out that the emulsion “is an emulsion containing about 10 to 20 per cent air and about 80 to 90 per cent cement by volume of the mixture at the application pressure” (Ex. 1, Col. 4, lines 24 to 27, R. 706). Such an emulsion is not particularly pointed out or distinctly claimed.

As a matter of fact, the claims give no indication of how the emulsion is to be formed, despite the fact that the method of forming the emulsion is one of the critical elements of the invention. Therefore, Reading has failed to define an identifiable invention.

**3. The claims do not distinctly point out and distinctly claim the feature of the invention that prevents the settling out of the solid components of the cement.**

Reading testified (R. 272) that one of the main objections to the method he employed for many years prior to his patented method, in spraying rubber cement, was that the solids in the cement settled out. There is no reference in any of the claims to this important feature of the invention. However, an examination of the specification discloses that this is allegedly a new function and

an important discovery in the art (Ex. 1, Col. 5, lines 7 to 27, R. 707). This alleged important feature of utilizing the emulsion to prevent settling of solids does not appear in the claims. In order for the function of the emulsion to have any meaning, we must first have a cement which contains solids which may settle out. This problem exists only with such cements and not all rubber cements contain pigments or other materials capable of settling. If a cement with no pigments or other materials capable of settling is used, then the emulsion has no function. It does not appear that any or all air emulsions will have such a function, and it must be presumed that only those emulsions containing a sufficient amount of air properly dispersed will be effective to prevent settling of solids, provided the cement contained solids which tended to settle out. The nature of the cement and the nature of the emulsion are interrelated. However, this interrelationship is not defined in the claims.

**4. The production of a non-explosive spray is not particularly pointed out or distinctly claimed.**

One of the most important claims made for the Reading invention is that it produces a non-explosive spray even though that spray contains an inflammable solvent. The testimony is uncontradicted that to produce a non-explosive spray with the emulsion employed by Reading certain very definite proportions of cement and air must be employed (R. 446-447). The Reading specification recognizes that there must be a definite ratio between the hydrocarbon solvent contained in the cement and the volume of air mixed with said hydrocarbon where it states:



“With the air and emulsion pressures set as described, about three cubic feet of air is used with about 1/6 ounce of cement. There is no need for the cement coating to dry and the camelback can be applied immediately to the sprayed carcass. Since there is used a very large volume of air and very small amount of cement the ratio of hydrocarbon solvent to air is below the range of explosive mixtures and there is no explosion or fire hazard in the vicinity of the spray gun operator. Also, for the same reason, the concentration of the hydrocarbon vapors produced during the spraying operation is sufficiently low to reduce to a minimum any health hazard to the operator.” (Ex. 1, Col. 4, lines 41-53, R. 706)

and

“If a liquid cement, instead of my emulsion, is fed directly to the spray gun with a stream of air under pressure, there is sludging and gumming of the spray gun and an uneven coating of cement results. It frequently becomes necessary to agitate and re-suspend the settled solids in the liquid. In addition, the explosion and health hazards are increased when using the liquid cement instead of my emulsion of gas in liquid cement.” (Ex. 1, Col. 5, lines 24-31, R. 707)

This non-explosive spray is definitely an important feature of the alleged invention. However, no mention of the production of such a spray or any conditions which would produce such a spray is found in the claims. As far as the claims are concerned, one who sprays an explosive spray would infringe.

The only example of the type spray to be used that is found in the specification uses 1/6 of an ounce of cement to 3 cubic feet of air. According to the testimony (String-

field R. 446), such a mixture would contain 1.1% of inflammable solvent. The lower limit of the inflammable range is 1.4% of inflammable solvent as admitted by Stringfield (R. 408).

Nevertheless the only claim that in any way attempts to point out any relation between the amount of cement and the amount of air contained in the spray is claim 4, which states:

“. . . continuously mixing the streams of emulsion and air in a mixing zone to form a spray of emulsion suspended in air containing of the order of a fraction of an ounce of cement to several cubic feet of air . . .”  
(Ex. 1, Col. 6, lines 36 to 39, R. 707)

Therefore, one who sprayed a mixture of 2/6 or even up to 9/10 of an ounce of cement with 3 cubic feet of air would be spraying an explosive mixture as admitted by the witness Stringfield (R. 446-447). Such a spray would come within the scope of all of the claims and would infringe them even though one of the claims to fame of Reading is that his spray is non-explosive.

A mixture containing from  $\frac{1}{3}$  of an ounce up to 1 ounce of cement with 3 cubic feet of air would clearly fall into the explosive range (R. 446-447). The record establishes, therefore, that the difference between an explosive and a non-explosive mixture depends upon a number of critical factors. Specific and limited ratios of air and cement are absolutely necessary to produce a non-explosive spray and may be obtained in various ways. Such ratios do not appear in the claims, excepting in claim 4, *which includes both explosive and non-explosive mixtures and, therefore, is meaningless*. It is submitted that each of the claims

fails to particularly point out or distinctly claim this important part of the invention.

5. **The pressure of the independent stream of air is not specified in the claims although critical.**

The Reading specification recognizes this, stating:

“The pressure of the compressed air fed to the spray gun 27 is set at about 150 to 200 pounds per square inch \* \* \* .” (Ex. 1, Col. 4, lines 32-34, R. 706)

Reading admitted that a critical factor in his process was the pressure of the independent stream of air, stating (R. 364-365):

“Q. Now, is it your contention that the bypass pressure that you employ on your independent stream of air is critical in the practice of your process?”

A. Yes; in a sense it is critical. It has to be. May I explain that?

Q. Yes; go ahead.

A. It has to be high enough in pressure so that it avoids cobwebbing of your material as it comes out of the gun, and it has to be high enough that it drives the cement deeply into the buffed pores of the tire.”

Criticism was leveled at the prior art because no specific pressure was specified for the independent stream of air admittedly included in said prior art (R. 114-115, 427-431). However, the claims in suit fail to mention any specific pressure for the independent stream of air.

As far as the claims of the Reading patent are concerned, the pressure of the independent air stream could be lower than the application pressure in the tank. Under such conditions the process would be inoperative. It is necessary that the pressure of the independent stream of

air be specified in the claims in order that an operative process be defined by the claims. Thus, this important and critical part of the invention is not particularly pointed out nor distinctly claimed.

It is obvious that the Reading claims come within the doctrine of the Supreme Court set forth in the case of *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271, 277, 69 S. Ct. 535, 538, and recently followed by this Court in *Winslow Engineering Company v. Smith*, 223 F. 2d 438. The language of the Reading claims is understandable and is free from ambiguity. However, they do not define an invention. If Reading made any contribution to or invention in the art, his claims do not particularly point out or distinctly claim this contribution or invention and as said by this Court in the Winslow decision:

“We think, however, that *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271, 277, 69 S. Ct. 535, 538, 93 L. Ed. 672, compels us to hold that these claims are invalid. In that case the district court had held that certain of the claims were too broad and comprehended more than the invention. The court of appeals disagreed holding that the claims should be held to be limited to certain items named in the specifications and said that the district court should have construed the claims: ‘as thus narrowed and limited by the specifications.’ The Supreme Court said, 336 U.S. at page 277, 69 S. Ct. at page 538: ‘The statute makes provision for specification separately from the claims and requires that the latter “shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.” R.S. § 4888, as amended, 35 U.S.C. § 33, 35 U.S.C.A. § 33. It would accomplish little to require

that claims be separately written if they are not to be separately read. While vain repetition is no more to be encouraged in patents than in other documents, and claims like other statements may incorporate other matter by reference, their text must be sufficient to "particularly point out and distinctly claim" an identifiable invention or discovery. We have frequently held that it is the claim which measures the grant to the patentee. \* \* \* While the cases more often have dealt with efforts to resort to specifications to expand claims, it is clear that the latter fail equally to perform their function as a measure of the grant when they overclaim the invention. When they do so to the point of invalidity and are free from ambiguity which might justify resort to the specifications, we agree with the District Court that they are not to be saved because the latter are less inclusive.'

"We are unable to note here any ambiguity in the claims in question. Hence, in this respect, we find ourselves in the position of the Court of Appeals of the Seventh Circuit in *Borg-Warner Corp. v. Mall Tool Co.*, 217 F. 2d 850, 856. There the court, which had been reversed in the *Graver Tank & Mfg. Co.* case, *supra*, noting that there was no ambiguity in the claims there in question, said that 'to limit those words \* \* \* by reference to the specifications seems to us to go beyond what we are permitted to do under the Supreme Court's decision in the *Graver* case.' "

\* \* \* \* \*

"We hold therefore that the appellant's claims are invalid for failure to 'particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery', or, as the new statute puts it, it has failed to conclude with claims 'particularly pointing out and distinctly claim-



ing the subject matter which the applicant regards as his invention.' ” (pages 443-444).

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**THE DISTRICT COURT ERRED IN NOT HOLDING THE CLAIMS OF THE PATENT IN SUIT AND EACH OF THEM INVALID IN LAW IN THAT SAID CLAIMS DEFINE NOTHING MORE THAN THE FUNCTION OF A MACHINE.**

It is a fundamental rule of patent law that a valid patent cannot issue for a process that covers merely the function of a machine or apparatus. *As a matter of fact, the only disclosure of the Reading process in the patent in suit is the description of the operation of the spray apparatus disclosed therein* (Ex. 1, Col. 3, line 68 to Col. 4, line 53, R. 706).

The process claims of the Reading patent in suit merely define the inherent function of the apparatus disclosed in the Reading patent. It is submitted that under the law these claims are invalid because they do not describe a patentable process, but merely describe the function of the Reading apparatus.

The Supreme Court has stated this rule in the landmark case of *Boyden Power-Brake Co. et al. v. Westinghouse et al.*, 18 S. Ct. 707, 716:

“ ‘But the term “process” is often used in a more vague sense, in which it cannot be the subject of a patent. Thus, we say that a board is undergoing the process of being planed; grain, of being ground; iron, of being hammered or rolled. Here the term is used subjectively or passively, as applied to the material operated on, and not to the method or mode of producing that operation, which is by mechanical means,

or the use of a machine, as distinguished from a process.

“ ‘In this use of the term, it represents the function of a machine, or the effect produced by it on the material subjected to the action of the machine. But it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produces it.’ ”

\* \* \* \* \*

“Most of the prior authorities upon this subject are reviewed in the recent case of *Locomotive Works v. Medart*, 158 U.S. 68, 15 Sup. Ct. 745, in which it was also held that a valid patent could not be obtained for a process which involved nothing more than the operation of a piece of mechanism, or the function of a machine. See, also, to the same effect, *Wicke v. Ostrum*, 103 U.S. 461, 469. \* \* \*”

In the case of *Demco, Inc. et al. v. Doughnut Mach. Corporation* (C.C.A. 4, 1932), 62 F. 2d 23, 25, the Court said:

“\* \* \* It is elementary that the mere function of a machine is not patentable, and that the claims of a patent must be construed in the light of the specifications and drawings to which they relate, and not given an interpretation so broad as to cover the function of the machine patented and thus protect against every possible machine with like function.”

See also:

*American Lava Co. et al. v. Steward, et al.*, 155 F. 731.

The Seventh Circuit Court in the case of *Interstate Folding Box Co. v. Empire Box Corporation*, 68 F. 2d 500, 501, clearly and succinctly stated the rule as follows:

“ “ “A valid patent cannot be obtained for a process which involves nothing more than the operation of a piece of mechanism, or in other words, for the function of a machine.” *Risdon Locomotive Works v. Medart*, 158 U. S. 68 at page 77, 15 S. Ct. 745, 748, 39 L. Ed. 899. \* \* \*”

For purposes of illustration, claim 1 (R. 707) of Reading is hereinbelow analyzed to establish that it only defines the function of the apparatus disclosed in said Reading patent:

Claim 1:

“A method of applying rubber cement which includes an inflammable solvent, comprising:

- a) “forming an emulsion of air in the cement in a dispersion zone by introducing said air under pressure into a substantial body of cement maintained in said zone at super-atmospheric pressures,”

This step is nothing more or less than the inherent function of the tank and air inlet tube of the Reading patent when air under pressure is introduced through the tube and into the tank containing the cement. This element covers the tank and tube of many of the prior art patents, particularly the patents to Shelburne No. 1,710,435, Gradolph No. 1,318,863 and McLean et al. No. 1,395,965.

- b) “continuously withdrawing a stream of the emulsion from the dispersion zone,”

This is the inherent function of the tank and the outlet tube of Reading, when the fluid in the tank is put under pressure and said fluid is withdrawn from the tank.

Similarly, Shelburne, Gradolph and McLean et al. inherently function to continuously withdraw a stream of fluid from their respective tanks.

c) "forming an independent stream of air,"

The forming of an independent stream of air is inherent in the operation of the Reading device. So also Shelburne, Gradolph and McLean inherently operate to form an independent stream of air.

d) "continuously mixing the emulsion stream with said independent stream of air in the mixing zone,"

This step is the inherent function of any spray gun. This inherent function is present in Shelburne, Gradolph and McLean.

e) "and continuously directing the resulting mixture of emulsion and air onto a surface to form a thin uniform coating of rubber cement thereon."

Again, this is the inherent function of the spray gun of Reading. It is also the inherent function of the spray guns of Shelburne, Gradolph and McLean.

Each of the claims of the Reading patent similarly describes the inherent function of the Reading apparatus.

As was said in the case of *Ludlow Manufacturing & Sales Co. v. Dolphin Jute Mills, Inc.*, 50 F. Supp. 395, 398, Per Curiam Affirmance, 145 F. 2d 471 (C.C.A. 3):

"It is our firm conviction that the claims in issue do not define a patentable method but define the peculiar and characteristic functions of the elements

of the apparatus recommended for its practice, and appropriately illustrated and described in the specifications of the patent. There is no suggestion in either the patent or the evidence that the method may be practiced by any other means. It seems reasonably clear from a reading of the patent in its entirety that the essence of the invention, if any, resides not in the method but in the apparatus, and particularly in the elements thereof defined in claim 10, hereinabove quoted. The successive operations of the purported method, as hereinabove stated, are inherent in the elements of the apparatus as the peculiar and characteristic functions thereof. It necessarily follows that the claims in issue are invalid.”

\* \* \* \* \*

“When the claims in issue are read and construed in the light of the prior art, as they must be, the absence of patentable invention seems to be clearly demonstrated. The successive operations of the purported method are inherent in devices of the prior art, several of which were admittedly in common use and others of which were disclosed by patents of the prior art. It is particularly significant here that these devices, and the elements of which they are comprised, are not only adaptable to the said operations, but the said operations are inherent in them as their normal and intended functions. It follows that the claims in issue, since they define the peculiar and characteristic functions of the apparatus recommended for the practice of the purported method, are anticipated by the devices of the prior art in which these functions are inherent.”

Each step in the Reading process is old in the identical art. Reading merely expressed his process claims by the use of different wording, in an attempt to distinguish his



process from the inherent function of his apparatus. This Court considered the identical situation in *Stauffer v. Slenderella Systems of California, Inc.*, 254 F. 2d 127, 130, where it said:

“\* \* \* The Stauffer device is a collection of elements, old in the identical art, brought together and differentiated semantically from prior devices. It is a mere aggregation. No new function is performed thereby. Not only a skilled mechanic, but the draftsman of ordinary good sense could have combined them to produce the result if he were confronted by wording from prior devices.”

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#### ANTICIPATION.

##### **Prior Uses.**

The evidence establishes three prior uses. Each of these prior uses meets the test of substantial identity with the Reading process. Said prior uses are those of Cahill and Hartman in the use of the method disclosed in Cahill patent No. 2,758,037 (filed June 17, 1953, Ex. 4, R. 769), and the prior uses of appellee, Ralph R. Reading.

The Patent Office did not consider any of these prior uses during the prosecution of the Reading application. Under such circumstances, the presumption of validity is substantially weakened if not completely destroyed.

In the case of *Lempco Products, Inc. v. Timken-Detroit Axle Co.*, 110 F. 2d 307, 310 (C.A. 6), the Court, in discussing the effect of a prior use not considered by the Patent Office, said:

“The Autocar prior use was not, however, before the examiner in the Patent Office and no presumption of validity may overcome a pertinent prior art reference not there considered . . .”

Cahill, in January of 1953, developed a method of spray painting rubber cement, and he employed this method in the retreading of tires from the 1st of January 1953 to the 7th of February 1953, when he considered his method had been perfected to such an extent that he could then manufacture and sell spray devices to practice his method of spraying rubber cement on tire carcasses. Mr. Cahill immediately embarked on the manufacture and sale of such devices and sold five spray devices from February 7, 1953 to July 23, 1953<sup>3</sup> (R. 625-628).

During the early period of the development of this method by Cahill he was assisted by a Mr. Hartman, a neighbor of his in Danville, Virginia (R. 625), who operated a tire retreading shop located directly across the street from Cahill's shop (R. 671). Mr. Hartman supplied Mr. Cahill with tires with which to practice his method of spray painting rubber cement (R. 624). In return for this assistance, Mr. Cahill, on February 7, 1953, gave to Mr. Hartman the original machine he had developed. A picture of this machine is in evidence as Ex. 9, R. 835.

Mr. Hartman employed this machine in practicing the Cahill method of spray painting rubber cement in the regular course of his tire retreading business from Feb-

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<sup>3</sup>July 23, 1953 is the critical date with respect to prior public uses because said date is one year prior to the date of the filing of the Reading patent application.

ruary 7, 1953 to July 1, 1953, and between these dates used said method of spray painting rubber cement on some 4,658 tires retreaded in his shop (Ex. 16, R. 844).

The Cahill method of spraying rubber cement included the following: a method of applying rubber cement which comprised an inflammable solvent, wherein the rubber cement and solvent were manually stirred and then placed into a tank, compressed air under superatmospheric pressure was introduced into said tank, the said cement was continuously withdrawn from the tank, an independent stream of air was formed, said independent stream of air and the stream of cement were continuously mixed in a mixing zone and the resulting mixture of rubber cement and air was continuously directed onto a surface to form a thin uniform coating of rubber cement thereon. In addition to the above, brushes were also employed to additionally smooth the sprayed cement in a thin film evenly over the surface of the tire. However, these brushes did not change or modify the spraying of the cement (R. 648).

This is substantially identical to the method set forth in claim 1 of the Reading patent.<sup>4</sup>

Appellee, Ralph R. Reading, testified that in December 1951 he began employing a method of spray painting rub-

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<sup>4</sup>Reading patent claim 1: A method of applying rubber cement which includes an inflammable solvent, comprising forming an emulsion of air in the cement in a dispersion zone by introducing said air under pressure into a substantial body of cement maintained in said zone at superatmospheric pressure continuously withdrawing a stream of the emulsion from the dispersion zone, forming an independent stream of air, continuously mixing the emulsion stream with said independent stream of air in a mixing zone, and continuously directing the resulting mixture of emulsion and air onto a surface to form a thin uniform coating of rubber cement thereon.

ber cement on tire carcasses for the identical purpose of the Reading patented process (R. 350), and continuously used this method in the commercial operation of his shop from that date down to September 1953 (R. 352). During this period Reading commercially employed this method on an average of from 300 to 400 tires per month that were retreaded in his shop, and sold these tires in the ordinary and regular course of his business (R. 352).

The Supreme Court, in passing on a prior public use by a patentee under similar circumstances to those of the Reading prior public use above mentioned, held in the case of *Electric Storage Battery Co. v. Shimadzu et al.*, 307 U.S. 5, 20, 59 S. Ct. 675, 684, the following:

“\* \* \* The ordinary use of a machine or the practise of a process in a factory in the usual course of producing articles for commercial purposes is a public use.

In the present case the evidence is that the petitioner, since June 1921, has continuously employed the alleged infringing machine and process for the production of lead oxide powder used in the manufacture of plates for storage batteries which have been sold in quantity. \* \* \*

The prior use of appellee, Ralph R. Reading, was substantially identical to that covered by the Reading patent in suit. This prior Reading public use included the following method: applying rubber cement which included an inflammable solvent wherein a mixture of rubber cement and solvent was placed in a tank and manually stirred, compressed air at superatmospheric pressure was introduced into said tank, the said cement was continu-

ously withdrawn from the tank, an independent stream of air was formed, said independent stream of air and the stream of cement were continuously mixed in a mixing zone and the resulting mixture of cement and air was continuously directed onto a surface to form a thin uniform coating of rubber cement thereon.

This method is substantially identical to the claims of the Reading patent (see footnote wherein claim 1 of Reading patent is set forth, page 43 herein).

Actually, the only difference between the processes of the Cahill and Reading prior uses and the Reading patented process is the inclusion of the old and well-known step of passing air under pressure through the fluid contained in the tank of the spray device. The passage of air through fluids in spray devices was very old at the time of the filing of the Reading application<sup>5</sup> so that Reading did not make any new advance in the art of spray painting in his patent.

It is submitted that these prior uses teach a process substantially identical with the Reading patented process. Any mechanic skilled in the art, desiring to agitate and pass air through the cement, would select this old step from the prior art. Such a selection would not amount to invention. As a matter of fact, Cahill tested this in January 1953 (R. 649).

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<sup>5</sup>The Court is referred to the prior art patents of Shelburne (Ex. 4, R. 765); Gradolph (Ex. 4, R. 753); Barton (Ex. 5, R. 780); Paasche (Ex. 5, R. 785); Seweryn (Ex. 5, R. 791); McLean et al. (Ex. 4, R. 759); Kline (Ex. 5, R. 795); Davis (Ex. 5, R. 818); and McIntosh (Ex. 5, R. 821); all pleaded as prior art and each of which discloses passage of air through fluid in the tank of a spray device. These patents are more fully discussed in this brief in the next section thereof entitled "Prior Patents".



The cement in the tank of either of the prior uses of Reading, Cahill or Hartman, when put under superatmospheric pressure, would absorb air so the cement sprayed in these processes would have air entrained therein (R. 354 and 451), and in that respect said cement would be similar to that called for in the Reading claims.

#### **Prior Patents.**

*The Patent Office did not consider the most pertinent prior art patents during the prosecution of the Reading application.*

The presumption of prima facie validity of a patent is destroyed where the most pertinent prior art was not cited or considered by the Patent Office during the prosecution of the application which results in the patent. This rule is well settled.

The Court of Appeals for the Ninth Circuit in *Gomez v. Granat*, 177 F. 2d 266, 268, stated the rule as follows:

“None of these prior patents were cited or considered by the patent office during the prosecution of the patent application for the Granat patent. In this situation it is argued that the presumption of prima facie validity is greatly weakened if not destroyed when pertinent prior art is not cited or considered by the patent office, and this court has so held. *Stoody v. Mills Alloys*, 9 Cir., 67 F. 2d 807; *Mettler v. Peabody Engineering Corp.*, 9 Cir., 77 F. 2d 56; *McClintock v. Gleason*, 9 Cir., 94 F. 2d 115.”

See also:

*Jacuzzi Bros., Inc. v. Berkeley Pump Co.*, 9 Cir.,  
191 F. 2d 632.

*Syracuse v. Paris*, 9 Cir., 234 F. 2d 65.

The District Court ruled that the method resulting from the use of the Elrick spray device was substantially identical to the method covered by the claims of the Reading patent, and that said Elrick method was an infringement of the claims of said patent. It is submitted that, under such circumstances, the normal methods of operation of mechanical spray devices disclosed in the prior art can rightfully be used as methods that are anticipations of the said Reading claims.

This rule is succinctly stated in the case of *MacDougald Const. Co. v. Finley*, 38 F. 2d 809, 810 (C.C.A. 5), where the Court said:

“\* \* \* In fact, a patent for a process is anticipated by a machine capable of performing the process and used successfully to that end.

“‘It is no new invention to use an old machine for a new purpose. The inventor of a machine is entitled to the benefit of all the uses to which it can be put, no matter whether he had conceived the idea of the use or not.’ *Roberts v. Ryer*, 91 U.S. 150, 157, 23 L. Ed. 267.”

It is interesting to note that the only description of the Reading process that can be found in the Reading patent is a description of the normal method of operation of the Reading apparatus (Ex. 1, Col. 3, line 68 to Col. 4, line 53, R. 706).

#### **Shelburne Patent No. 1,710,435.**

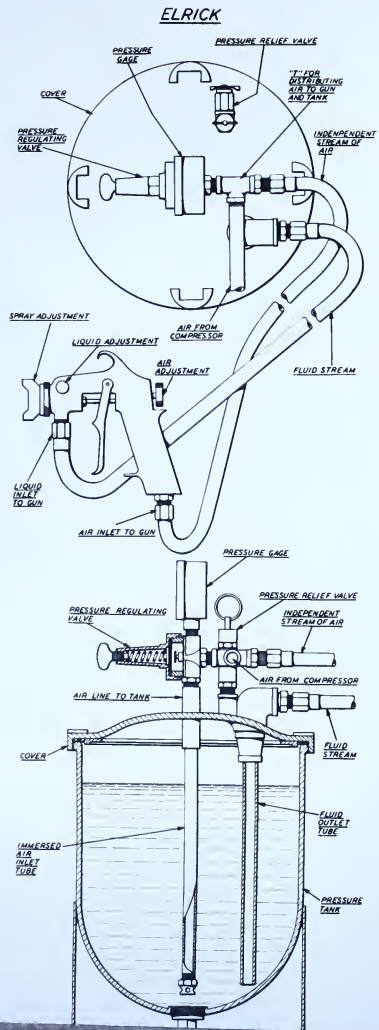
In Fig. 3, and in the specification of the Shelburne patent (Ex. 4, R. 765), there is disclosed a paint spraying device that is identical in construction, mode of operation and result to that of the Elrick device and method

here held to be an infringement of the patent in suit. Naturally, when the Shelburne spray device is employed in spraying a fluid, there comes into being a method of spraying a fluid in the same manner as a method comes into being from the operation of the apparatus disclosed in the Reading patent or in the use of the Elrick device. An examination of the Elrick device and the device disclosed in the Shelburne patent Fig. 3 establishes that these two devices are identical in construction, and in the method that results from the operation of these two devices. To establish substantial identity of the method resulting from the use of the Shelburne device, there is set forth below the method that would result from normal operation of the Shelburne device (Fig. 3):

Rubber cement and solvent are placed in the tank 8. Air under pressure is passed through the air inlet tube 26 and into the tank 8; said air under pressure also passes through and agitates the fluid in the tank and by the passage of air through said fluid an emulsion (as contended for by Reading) of air and fluid is formed. The fluid in the tank is continuously withdrawn from the tank through the outlet tube 9a. An independent stream of air is formed and passes through the T 19a and hose 21 to the spray gun 14. The stream of fluid continuously withdrawn from the tank and the independent stream of air is continuously mixed in the spray gun 14 which provides a mixing zone. The resulting mixture of fluid and air that passes through the spray gun is directed onto a surface to form a thin coating.

The process steps above stated inherently result from the normal operation of the Shelburne device. This proc-

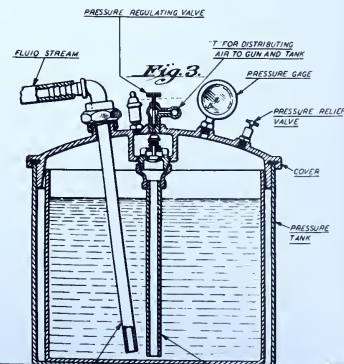
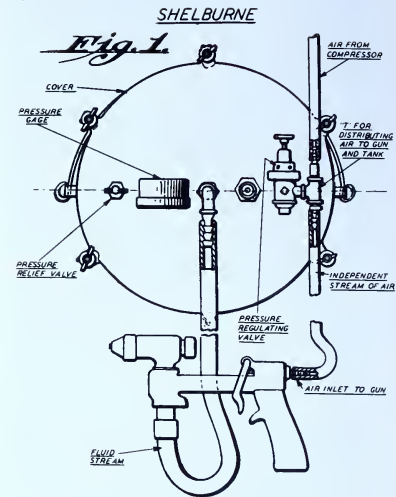
THE METHODS INHERENTLY RESULTING FROM THE OPERATION OF THE ELRICK DEVICE AND THE DEVICE DISCLOSED IN THE SHELBURNE PATENT NO. 1,710,435 (Ex. 4, R. 365) ARE IDENTICAL



The process resulting from the operation of the Elrick and Shelburne devices is as follows:

1. Fluid is placed into the pressure tank;
2. Air under pressure is passed through the fluid by introducing said air under pressure into the body of the cement in the tank through the immersed air inlet tube and out of the pressure relief valve, thus agitating said fluid (Reading contends this forms an emulsion in the Elrick process. Therefore, by the same reasoning, Shelburne, who teaches agitation by identical means (Ex. 4, R. 767, lines 25-39), would also form an emulsion);
3. Fluid is continuously withdrawn from the pressure tank through the fluid outlet tube;
4. An independent stream of air is formed;
5. The fluid stream and said independent stream of air are continuously mixed in a mixing zone at the outlet of the spray gun;
6. The mixture of fluid and air is continuously directed onto a surface to form a thin coating of fluid thereon.

If the operation of the Reading device results in a process then the above process steps inherently result from the normal operation of the Elrick and Shelburne devices. Therefore, if the Elrick process infringes Reading, so would Shelburne, and the maxim "That which infringes if later anticipates if earlier" must be applied.







ess is identical in all respects to the process resulting from the normal operation of the Elrick device.

There is set forth on the chart opposite this page detail drawings of the Elrick device and of the device shown on Fig. 3 of the said Shelburne patent. The chart also sets forth the process steps resulting from the normal operation of said two devices.

It is therefore submitted that the Shelburne patent not having been considered by the Patent Office during the prosecution of the Reading patent completely destroys any presumption of validity attaching to the Reading patent and is, as a matter of fact, a complete anticipation of Reading.

#### **Gradolph Patent No. 1,318,863.**

The same situation as exists with Gradolph is found in the Shelburne patent. The Gradolph patent (Ex. 4, R. 753) discloses a device for spray painting and the normal operation of the Gradolph device by one skilled in the art results in a method of spray painting that is completely anticipatory of the Reading patent in suit, and is identical with the method resulting from the use of the Shelburne, Reading or Elrick devices.

Gradolph teaches the introduction of fluid into the pressure tank 1. An air inlet pipe 42 is provided which serves to introduce air under pressure into the tank into the fluid adjacent the bottom of the tank through a number of openings 43. A portion of the high pressure air is diverted directly to the spray gun. The fluid in the tank, which has been agitated by passage of air therethrough, is forced by pressure out of the tank to the spray gun,

where it is mixed in a mixing zone with the independent stream of air, and this resulting mixture is sprayed onto a surface exactly the same as in Elrick.

**McLean et al. No. 1,395,965.**

Again, the McLean et al. patent (Ex. 4, R. 759) discloses an apparatus that when operated in its normal way, results in a method of spray painting. This method is as follows:

Fluid is introduced into the pressure tank 1. An air inlet tube 15 permits air under a high pressure to be fed into the tank adjacent the bottom of said tank so that the fluid is agitated and charged when put under pressure. McLean et al. also divides said high pressure air so that a portion goes into the tank and a portion directly to the spray gun. The charged fluid under pressure is forced out of the tank to the spray gun where it is mixed with the independent stream of air and sprayed onto a surface.

The above described methods inherently resulting from the normal operation of the devices disclosed in the patents to Shelburne, Gradolph and McLean et al. are identical to the method that results from the operation of the Elrick device that was held by the District Court to be an infringement of the claims of Reading. Therefore, if the method resulting from the operation of the Elrick device is an infringement of the Reading claims, then the method inherently resulting from the operation of the Shelburne, Gradolph and McLean et al. devices would also be an infringement. Being earlier in time than Reading, they are therefore anticipations of the Reading patent.

**Cahill Patent No. 2,758,037.**

The method disclosed and claimed in the Cahill patent (Ex. 4, R. 769) is the method that was discussed under the subdivision entitled "Prior Uses". Cahill not only discloses the apparatus of a spray device but discloses the method resulting from the operation of said spray device, and specifically describes the method of use of said device. Cahill also claims as a method the use of the Cahill device. The Court is referred to the method resulting from the use of the Cahill device set forth on page 43 of this brief.

It is submitted that with the knowledge of spray painting rubber cement disclosed in either the prior Cahill and Hartman uses and the Cahill patent, one skilled in the art, who desired to spray rubber cement, would, by a mere matter of selection, employ the devices of either Shelburne, Gradolph or McLean et al. in practicing a method of spray painting rubber cement that was identical to the method of Elrick and, therefore, under the well known rule "That which infringes if later anticipates if earlier", would be following an old process and could not be considered as infringing the Reading patent in suit.

All that Reading did was to spray paint rubber cement, an old thing by the Cahill patent and the Cahill, Hartman and Reading prior uses, using the old process inherently resulting from the use of the devices disclosed in the patents to Shelburne, Gradolph and McLean et al.

The Supreme Court in the early case of *Pennsylvania R. Co. v. Locomotive Engine Safety Truck Co.*, 4 S. Ct. 220, 222, in following this rule, said:

“It is settled by many decisions of this court, which it is unnecessary to quote from or refer to in detail, that the application of an old process or machine to a similar or analogous subject, with no change in the manner of application, and no result substantially distinct in its nature, will not sustain a patent, even if the new form of result has not before been contemplated. \* \* \*”

See also:

*Pierce v. Muehleisen*, 226 F. 2d 200 (C.A. 9).

In the recent case of *Ralph F. Stallman v. Casey Bearing Company, Inc.*, 144 F. Supp. 927, 929, (U.S.D.C. N.D. California, S.D. 1956) which was affirmed by this Court at 244 F. 2d 905, wherein this Court agreed with the District Court in its conclusion both as to the law applicable to the evidence and the legal conclusion reached with reference to the application of the prior art, the District Court said:

“It is apparent that the extent of plaintiff’s contribution to the art was to point out that old devices had a theretofore unperceived advantage which would be realized in *some* old and common applications, but *not* in others. In the words of the Supreme Court in *General Electric Co. v. Jewel Incandescent Lamp Co.*, 1945, 326 U.S. 242, 249, 66 S. Ct. 81, 84, 90 L. Ed. 43, ‘that did not advance the frontiers of science in this narrow field so as to satisfy the exacting standards of our patent system. Where there has been use of an article or where the method of its manufacture is known, more than a new advantage of the product must be discovered in order to claim invention.’ This is so even though the recognition of the new advantage may benefit industry and bring new commercial success to the product.

“Thus, solely from the comparison of the prior art with the teaching of plaintiff’s patent, without weighing the testimony of any witnesses, expert or otherwise, the only reasonable conclusion that can be drawn is that the patent is invalid. \* \* \*” (Emphasis Court’s)

It is submitted that the prior art above analyzed, none of which was before the Patent Office during the prosecution of the Reading application, completely anticipates the said Reading patent.

If the claims of the patent in suit are construed to include appellant’s process, then by the same token, they include the prior art and these claims fall under the rule uniformly followed of “That which would infringe if later would anticipate if earlier.”

*Peters v. Active Mfg. Co.*, 129 U.S. 530, 537.

*Knapp v. Morss*, 150 U.S. 221, 228.

*Miller v. Eagle Mfg. Co.*, 151 U.S. 186, 200.

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**READING DID NOTHING MORE THAN EXERCISE MECHANICAL SKILL IN SELECTING AN OLD DEVICE AS A MEANS TO PRACTICE HIS PROCESS.**

It is admitted (R. 364) that the only difference between the early process of spraying cement employed by Reading in his retreading shop from December 1951 to October 1953 and the claimed process of the Reading patent<sup>6</sup> was in “forming an emulsion of air in the cement in a dispersion zone by introducing said air under pressure

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<sup>6</sup>In his testimony (R. 364) Reading mentions *increased* bypass air and changed material and air tips—these things are not claimed.



into a substantial body of cement maintained in said zone at superatmospheric pressure" (Ex. 1, Claim 1, R. 707). This was accomplished merely by adding to the old paint spray pot of the early Reading prior use an air inlet tube that terminated adjacent the bottom of the pot. In other words, Reading added to his old process a step that was old in the art.

Reading did not invent the process resulting from the operation of this device. The process resulting from the use of such a spray pot is inherent in the operation of the Reading device and is the precise process resulting from the normal operation of the device disclosed in either the Shelburne, Gradolph or McLean et al. patents. The function of introducing air under pressure into a body of the fluid in the tank is inherent in the operation of the devices of these three prior patents.

Any mechanic who desired to introduce air under pressure into fluid in a spray pot would employ this old step,—a step that was first disclosed in the patent to Barton No. 696,158 of 1902. That this is a step well known is evidenced by the fact that in addition to the patent to Barton, the prior patents to Paasche (1914, Ex. 5, R. 785), Seweryn (1918, Ex. 5, R. 795), Gradolph (1919, Ex. 4, R. 753), McLean et al. (1921, Ex. 4, R. 759), Kline (1924, Ex. 5, R. 795), Shelburne (1929, Ex. 4, R. 765), Davis (1933, Ex. 4, R. 818) and McIntosh (1935, Ex. 5, R. 821) all disclose the introduction of air under pressure into the body of the fluid in a spray pot. Whether these patents perform this step for the purpose of forming an emulsion or to agitate is immaterial because, for the purposes of this suit, Reading contends and the District Court

agreed, in its Findings of Fact (Finding VIII, R. 59), that mere agitation forms the emulsion called for in the Reading claims.

In view of the teachings of the art, it required only mechanical skill to develop the patented process and therefore there is no invention. This Court, in the case of *Fowler v. Vimcar Sales Company*, 216 F. 2d 263, 265-266, under similar circumstances, held:

“The difference disclosed and claimed by appellant Fowler in Patent No. 2,516,196 over the prior art is so trivial and insignificant that it may be said to be the work of a skilled mechanic and not worthy of being classed as an invention. We feel the following is applicable here.

‘The new device, however useful it may be, must reveal the flash of creative genius not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain.’ *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84, 62 S. Ct. 37, 41, 86 L. Ed. 58.

‘An improvement to an apparatus or method, to be patentable, must be the result of invention, and not the mere exercise of the skill of the calling or an advance plainly indicated by the prior art.’ *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U.S. 477-487, 55 S. Ct. 455, 458, 79 L. Ed. 1005.

A number of prior art users manufactured, sold and used adjustable jamb type garage door hardware which was the same or substantially the same as the hardware of the patent at a prior date to any alleged invention of the patent in suit, and these prior art users were apparently not considered by the Patent

Office when the patent in suit was issued. Had there been any such consideration it is quite obvious from the evidence submitted to the trial Court that the patent would not have issued.”

See also:

*Gomez et al. v. Granat Bros. et al.*, 177 F. 2d 266, 268, 269.

*Pierce v. Muehleisen*, 226 F. 2d 200, 204 (C.A. 9, 1955).

*Jacuzzi Bros., Inc. v. Berkeley Pump Co., et al.*, 191 F. 2d 632, 636, 637 (1951).

*Aro Equipment Corporation v. Herring-Wissler Co.*, (C.A. 9, 1936), 84 F. 2d 619, 622.

*Ray, et al. v. Bunting Iron Works*, 4 F. 2d 214, (C.A. 9, 1925).

*Bailey v. Sears, Roebuck & Co.*, 115 F. 2d 904, 907 (C.A. 9, 1940).

Reading made only minor changes in adapting the old methods inherently resulting from the use of the prior art devices of Shelburne (Ex. 4, R. 765), Gradolph (Ex. 4, R. 753) and McLean et al. (Ex. 4, R. 759). These prior spray methods were common to many fields and, as was said in *Delco Chemicals, Inc. v. Cee-Bee Chemical Co., Inc.*, 157 F. Supp. 583, 590:

“Where, as here, use of a cleaning process or method is common to many fields, ‘its application to a new field ordinarily involves no more than ordinary mechanical skill.’ *Welsh Mfg. Co. v. Sunware Products Co.*, supra, 236 F. 2d at page 226; *Concrete Appliances Co. v. Gomery*, 1925, 269 U.S. 177, 185, 46 S. Ct. 42, 70 L. Ed. 222; *Vandenburgh v. Truscon Steel Co.*, 1923, 261 U.S. 6, 15, 43 S. Ct. 331, 67 L.

Ed. 507; *Lovell Mfg. Co. v. Cary*, 1893, 147 U.S. 623, 633-634, 13 S. Ct. 472, 37 L. Ed. 307.

“Nor is invention ordinarily involved ‘even though changes or modifications are essential to the practical application of the method \* \* \* to the new use \* \* \*.’” *International Steel Wool Corp. v. Williams Co.*, supra, 137 F. 2d at page 346; cf. Reviser’s note to 35 U.S.C. § 101 (1952); *Jungersen v. Ostby & Barton Co.*, 1949, 335 U.S. 560, 69 S. Ct. 269, 93 L. Ed. 235; *Mandel Bros., Inc., v. Wallace*, 1948, 335 U.S. 291, 69 S. Ct. 73, 93 L. Ed. 12; *Sinclair & Carroll Co., v. Interchemical Corp.*, 1945, 325 U.S. 327, 65 S. Ct. 1143, 89 L. Ed. 1644; *Honolulu Oil Corp. v. Halliburton*, 1939, 306 U.S. 550, 59 S. Ct. 662, 83 L. Ed. 980.”

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#### NON-INFRINGEMENT.

- a) **Elrick Rim Company does not infringe the patent in suit because Elrick Rim Company neither forms nor sprays an emulsion of air in rubber cement, nor forms or sprays a rubber cement saturated with air as called for by the claims of the patent in suit.**

The Reading patent teaches and claims the spraying of an emulsion of rubber cement.

For example, the claims (R. 707) of the Reading patent call for the following:

Claim 1: “. . . forming an emulsion of air in the cement in a dispersion zone by introducing said air under pressure into a substantial body of cement . . .” (Ex. 1, col. 5, lines 43-45, R. 707.)

Claim 2: “. . . introducing a quantity of air at super-atmospheric pressure into the cement under emulsion conditions to form a stable dis-

persion of gas and cement under pressure, . . .” (Ex. 1, col. 5, line 56 to col. 6, line 1, R. 707.)

Claim 3: “. . . introducing a quantity of air into the cement under conditions to form an emulsion of air in the liquid cement . . .” (Ex. 1, col. 6, lines 13-15, R. 707.)

Claim 4: “. . . introducing a quantity of air into the liquid cement under conditions to form an emulsion of air in the cement . . .” (Ex. 1, col. 6, lines 29-31, R. 707.)

Mr. Stringfield, the expert witness for appellees, admitted on cross-examination that the Elrick process does not form an emulsion (R. 438). The expert witnesses for appellant, Mr. Wolk and Dr. Petersen, also so testified at R. 96-97 and R. 511, respectively.

It was finally resolved that an “emulsion”, as that word is usually defined, was not formed as a result of the Reading process (R. 438) but rather in following the teachings of Reading in the use of an initial pressure of 40 pounds per square inch and then reducing that pressure to an application pressure of from 10 to 15 pounds per square inch, the rubber cement became supersaturated with minute air bubbles (R. 410-412 and 512).

In other words, to come within the teachings of the Reading patent and its claims, there must be formed and sprayed a rubber cement that is supersaturated with minute air bubbles. Elrick Rim Company does not form and spray a rubber cement of this character and therefore does not infringe. Mr. Stringfield testified on direct examination that the Reading process results in super-



saturation of the cement with minute air bubbles, stating (R. 410):

“\* \* \* And what Mr. Reading accomplishes when he pressurizes it to 30 or 40 pounds is to immediately greatly increase the solubility, the amount of air that has been dissolved in the cement. Then he releases the pressure to 15 pounds. He immediately has a supersaturated solution, which tends to release air in the form of minute bubbles all through the liquid, but which, as is common with supersaturated solutions, does not come back to equilibrium immediately. \* \* \*” (R. 410.)

On cross-examination, Mr. Stringfield was forced to admit that the Elrick process does not form a cement that is supersaturated with air bubbles. His testimony in this regard is as follows (R. 444-445):

“Q. So, as I understand your answer now, there would be no supersaturation in the Elrick tank?

A. Presumably in the tank itself there might not be supersaturation.

Q. There would not be supersaturation, that is the fact, isn't it?

A. Yes, I think you are right there.”

Dr. Petersen corroborated Mr. Stringfield's testimony on both of these points, testifying as follows (R. 512-513):

“Q. Now, in the tests, and in the preparation of the Reading device for these tests, would the cement be supersaturated with air as a result of the action of that device that was used in those tests?

A. Well, yes. The air is introduced at 40 pounds per square inch, so that the amount of air that would go into solution would approach the solubility of air

in a cement mixture at 40 pounds per square inch. When the pressure is reduced back to 10 pounds per square inch, the amount of air in solution is greater than the solubility at 10 pounds per square inch, so that it would be released in the form of fine bubbles throughout the cement, similar to a bottle of soda water where carbon dioxide would be spontaneously formed in all parts of the liquid.”

\* \* \* \* \*

“Q. And would the cement in this Elrick device, as you have described it, be supersaturated with air?

A. Well, the device is operated holding the pressure at 10 pounds per square inch or less, as was testified to yesterday by Mr. Stringfield. There may be some pressure drop through the unit so that the pressure would be at a maximum of 10 pounds per square inch, so that the amount of gas or air in this case that would go into solution would approach the solubility of air at 10 pounds per square inch, and could not exceed that. Since the device is never to be brought over 10 pounds per square inch, it could never be supersaturated with respect to 10 pounds per square inch.”

In view of this uncontradicted testimony that Reading’s process results in the formation of a cement that is supersaturated with minute air bubbles and that the Elrick process does not form cement that is supersaturated with air bubbles, Elrick Rim Company cannot infringe the claims of the Reading patent.

The Reading patent is in a crowded art, the art of spray painting, and therefore must be narrowly construed. This fundamental rule of patent law was recently reaffirmed by this Court in the case of *Kwikset Locks, Inc. v. Hillgren*, 210 F. 483, 490, where this Court said:

“The Kwikset knob patent is in a crowded field; therefore, its scope must be narrowly limited. \* \* \*”

As noted above, each of the claims of the Reading patent calls for the formation of an emulsion. The claims do not define the steps to be employed in the formation of said emulsion. Therefore, the specification must be referred to for this purpose. The only teaching of the Reading patent on the formation of his emulsion is as follows:

“\* \* \* Compressed air at an initial pressure of about 40 pounds per square inch gage, as controlled by reducing valve 25, is dispersed in the liquid cement through pin holes 21. After several seconds the pressure vessel 10 is filled with an air in cement emulsion under a pressure of about 40 pounds per square inch gage. By adjustment of reducing valve 25, the pressure in vessel 10 is then reduced to about 15 pounds per square inch gage for normal application purposes. The initial pressure can, however, be higher than 40 pounds per square inch, and may be as high as say 200 pounds per square inch gage, or higher . . .” (Ex. 1, col. 4, lines 8-19, R. 706.)

Following these process steps, a cement that is supersaturated with minute air bubbles is formed. It is interesting to note that Reading recognizes that a higher initial pressure than 40 pounds can be employed. However, he fails to teach that a lower pressure than 40 pounds can be employed in the preparation of his emulsion.

The Elrick process of preparing cement does not follow the process steps called for by Reading and is in no way similar to Reading.

Elrick Rim Company instructs the users of its apparatus as follows:

“Adjust air pressure regulator to 10# as shown on air gauge. Do not use over 10# as spray gun has been adjusted for this pressure.

Mix cement thoroughly by air agitation. This is done by opening air release valve located at rear of cover (not the safety valve). Allow air to pass through tank for about 3 minutes for complete mixing. If sprayer is not used for several hours, agitate before using.” (Ex. 8, R. 833.)

It is obvious that these steps of the Elrick process are not the same as the steps required to practice the Reading process as disclosed in the Reading patent. More important, the steps of the Elrick process are not the equivalent of the steps of the Reading process because, as admitted by the witness Stringfield and corroborated by the witness Petersen, the steps of the Elrick process do not result in the formation of the rubber cement saturated with minute air bubbles (R. 410, 444, 445 and 512). Stringfield also admitted on cross-examination that the steps of the Elrick process do not form an emulsion (R. 438).

It is submitted that the record establishes, without any question, that the Elrick process does not form either an emulsion or a rubber cement supersaturated with minute air bubbles. Therefore, it cannot infringe the claims of the patent in suit.

- b) The claims of the Reading patent call for an "emulsion" and the specification must be examined to determine the proper meaning of this term.

Each of the claims of the patent in suit calls for the formation of an emulsion. What is an emulsion?

Webster's New International Dictionary, Second Edition, defines the word "emulsion" as: "a dispersion of fine particles or globules of a liquid in a liquid".

The witness Petersen defined an emulsion at R. 514 as:

"\* \* \* the dispersion of a liquid within another liquid."

The District Court introduced into the record (R. 152) the following definition of an emulsion from Chambers Chemical Dictionary:

"A colloidal suspension of one liquid in another; e. g., milk."

The emulsion called for in the claims does not come within the ordinary meaning or definition of the word "emulsion" as above set forth. Therefore, for an explanation of the word "emulsion" as used in the claims and an illustration of the Reading invention, one must refer to the Reading specification. Where a word employed in a claim is not used in its ordinary meaning, the specification must be examined to determine the proper meaning of that word.

In *Kugelman v. Sketchley*, 133 F. 2d 426, 427, this Court, in stating the rule, said:

"To ascertain the meaning of terms used in the claims, we look to the specification. *Motoshaver, Inc., v. Schick Dry Shaver*, 9 Cir., 112 F. 2d 701, 702;



L. McBrine Co. v. Silverman, 9 Cir., 121 F. 2d 181, 182. \* \* \*”

This Court has universally followed the rule that the claims of a patent must be read in light of the specification. A clear statement of the rule by this Court is found in the case of *Lanyon v. M. H. Detrick Co.*, 85 F. 2d 875, 877, where the Court said:

“\* \* \* The specification may be referred to, to limit the claims, and to explain and illustrate them, but they cannot be enlarged by the specification. \* \* \*”

Also, in *Schnitzer et al. v. California Corrugated Culvert Co. et al.*, 140 F. 2d 275, 276, this Court said:

“The claim is to be read in connection with the specifications. *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403, 432, 22 S. Ct. 698, 46 L. Ed. 968; *American Fruit Growers v. Brogdex Co.*, 283 U.S. 1, 51 S. Ct. 328, 75 L. Ed. 801; *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 312 U.S. 654, 61 S. Ct. 235, 85 L. Ed. 132; *Payne Furnace & Supply Co. v. Williams-Wallace Co.*, 9 Cir., 117 F. 2d 823; *L. McBrine Co. v. Silverman*, 9 Cir., 121 F. 2d 181; *Corcoran v. Riness*, 9 Cir., 128 F. 2d 870. Where the claim uses broader language than the specifications, reference may be had to the latter for the purpose of limiting the claim. *McClain v. Ortmyer*, 141 U.S. 419, 12 S. Ct. 76, 35 L. Ed. 800; *Magnavox Co. v. Hart & Reno*, 9 Cir., 73 F. 2d 433; *Lanyon v. M. H. Detrick Co.*, 9 Cir., 85 F. 2d 875. \* \* \*”

There is no question but that the claims of Reading use broader language than the specification. Therefore, under the above quoted rule, the specification must be referred to for the purpose of limiting the claims.

Again, this Court in a similar situation presented in the case of *McRoskey v. Braun Mattress Co.*, 107 F. 2d 143, 146, said:

“Whether the mattress depressing members of the frames described in the claims are conical-shaped or not, the claims do not state, but, since conical-shaped mattress depressing members are the only ones mentioned in the specification, it must be assumed that the mattress depressing members of the frames described in the claims are likewise conical-shaped. For the claims must be read in the light of the specification. *Henry v. Los Angeles*, 9 Cir., 255 F. 769, 780.”

As in the *McRoskey* case, where the claims did not state whether or not the mattress depressing members of the frame described in the claims were conical-shaped, Reading in his claims does not tell the character of his emulsion. As in the *McRoskey* case, it must be assumed that the emulsion called for in said Reading claims is the emulsion described in the Reading specification; namely, an emulsion formed with “an initial pressure of about 40 pounds per square inch gage” and after several seconds “By adjustment of reducing valve 25, the pressure in the vessel 10 is then reduced to about 15 pounds per square inch gage for normal application purposes.”

When the Reading claims are limited to the invention described in his specification, and they must be because the claims use broader language than the specification, then appellant does not infringe. Appellant does not employ an initial pressure of 40 pounds and then reduce said initial pressure to 15 pounds, as called for in the Reading specification. On the contrary, as admitted by Mr. Stringfield, Elrick Rim Company agitates at a pres-

sure of less than 10 pounds and never employs a pressure over 10 pounds (R. 435-436).

Even if the Reading patent is given the broadest interpretation possible with respect to the so-called emulsion and consider his emulsion merely supersaturation of air in the cement and solvent, no such condition exists in the Elrick process (R. 444-445, 512).

Thus, it is seen that the method resulting from the use of appellant's device does not follow the method covered by the claims of the patent in suit as limited by the specification, and therefore appellant does not infringe said claims.

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**THE DISTRICT COURT ERRED IN AWARDING  
ATTORNEYS' FEES TO APPELLEES.**

It is submitted that the District Court was completely in error when it entered an order awarding the sum of \$7,500.00 as attorneys' fees to the appellees herein. This suit was one brought under the Declaratory Judgments Act and resulted from the appellees notifying appellant that it infringed the Reading Patent No. 2,721,148 (Ex. P, R. 863). In addition to notifying the appellant directly, appellee, Reading Tire Machinery Co., Inc., notified a substantial number of appellant's customers (R. 243), as well as publishing a notice in the T.B.A. News, a widely distributed trade magazine (R. 231).

The purpose of the Declaratory Judgments Act, as applied in patent law, is to permit one charged with infringement of a patent to immediately bring a Declaratory Judgments Action to determine whether or not the charge of infringement is good and whether or not the

patent is valid. In addition, it is to stop acts of unfair competition in the destruction of a person's business by the wholesale notification of customers of patent infringement, thus intimidating such customers and destroying usual business relations between parties.

After receipt of this notice of infringement (Ex. P, R. 863), appellant attempted to amicably settle this controversy without success (Ex. Q, R. 865 and Ex. V, R. 867). Thereafter appellant, in an attempt to protect its business, followed the course prescribed by the Declaratory Judgments Act and brought suit for an early determination of whether the Reading patent was valid and infringed by it and to stop the wholesale notification of its customers of infringement of the Reading patent. There was nothing malicious or vexatious in appellant's conduct.

On February 23, 1956, the date the complaint herein was filed, due to overt acts of appellees in notifying appellant and appellant's customers of infringement, a justiciable controversy existed between appellant and appellees respecting validity and infringement of the Reading patent. Appellant could not compel appellees to file suit and appellees, unless enjoined, could go on indefinitely charging infringement and threatening customers of appellant.

This Court recognized the necessity of permitting one to file suit under such circumstances where, in the case of *Beacon Theatres v. Westover*, 252 F. 2d 864, 873, it said:

“\* \* \* We think that the question whether the plaintiff stated a claim properly triable before the court

sitting in equity must be judged as of the time when the complaint was filed. At that time, October 31, 1956, the defendant had brought no suit; all that plaintiff was confronted with at that time were the threats and duress directed to it and to the distributors. The counterclaim was not filed until February 18, 1957. Obviously prior to the time when it filed its complaint plaintiff was not in a position to compel the bringing of an action by the defendant at any stated time. Consistently with the allegations of the complaint defendant, unless enjoined, could go on indefinitely threatening the distributors and the plaintiff with future suits; and as long as the threats worked, defendant would have its way and the business of the plaintiff would be seriously limited. \* \* \*

In the above decision, this Court recognizes that where rights of a party are being interfered with, that party's only remedy is to present the claim to a court of equity for determination rather than permitting acts to go on indefinitely that would destroy said party's business.

It cannot be said that appellant brought this suit in bad faith or unfairly. Appellant filed suit only after notice of infringement to itself and its customers. This Court recognized that the element of bad faith or unfairness is necessary to an award of attorneys' fees where, in the case of *Park-In Theatres v. Perkins*, 190 F. 2d 137, 142, it said:

“\* \* \* ‘The court may in its discretion award reasonable attorney's fees to the prevailing party upon the entry of judgment on any patent case.’ Act of August 1, 1946, 60 Stat. 778, 35 U.S.C.A. § 70. But in granting this power, Congress made plain its intention that such fees be allowed only in extraor-



dinary circumstances. The Reports of House and Senate Committees recommending this enactment provided in identical terms that 'It is not contemplated that the recovery of attorney's fees will become an ordinary thing in patent suits, \* \* \*. The provision is also made general so as to enable the court to prevent a gross injustice to an alleged infringer.' 1946 U.S. Code Congressional Service 1386, 1387. Thus, the payment of attorney's fees for the victor is not to be regarded as a penalty for failure to win a patent infringement suit. The exercise of discretion in favor of such an allowance should be bottomed upon a finding of unfairness or bad faith in the conduct of the losing party, or some other equitable consideration of similar force, which makes it grossly unjust that the winner of the particular law suit be left to bear the burden of his own counsel fees which prevailing litigants normally bear. The cases support this view. *Phillips Petroleum Co. v. Esso Standard Oil Co.*, D.C.D. Md. 1950, 91 F. Supp. 215, affirmed 4 Cir., 1950, 185 F. 2d 672; *Associated Plastics Co. v. Gits Molding Corp.*, 7 Cir., 1950, 182 F. 2d 1000; *Union Nat. Bk. of Youngstown, Ohio v. Superior Steel Corp.*, D.C.W.D. Pa. 1949, 9 F.R.D. 117; *Hall v. Keller*, D.C.W.D. La. 1949, 81 F. Supp. 835, modified (on other grounds) 5 Cir., 1950, 180 F. 2d 753, certiorari denied 1950, 340 U.S. 818, 71 S. Ct. 48; *Lincoln Electric Co. v. Linde Air Products Co.*, D.C.N.D. Ohio 1947, 74 F. Supp. 293, affirmed 6 Cir., 1948, 171 F. 2d 223."

Appellant did not infringe the patent in suit in bad faith. It merely took an old and well-known paint spray pot and manufactured and sold said old paint spray pot to spray rubber cement and solvent. This was done at a

time when the spray painting of rubber cement was old because of Cahill's prior use.

The only actual basis for the award of attorneys' fees is the statement found in the District Court's Memorandum Decision where the Court said (R. 32):

“As the Plaintiff forced the litigation upon the Defendant and sought not only declaration of invalidity and damages for unfair competition, but attorneys' fees also, under circumstances which the Court thinks were not justified, in view of the recency of the issuance of the Defendant's patent, the Court is of the view that in this case the Defendant should recover attorneys' fees against the Plaintiff. The amount will be determined upon a showing to be made before this Court on notice to be given by the Defendants.”

This statement by the Court is completely in error. The appellant did not force this litigation on appellees but rather appellees took the initiative and notified appellant of infringement, thereby raising a justiciable controversy between the parties, and thus forcing appellant into the position of having to bring suit under the Declaratory Judgments Act to resolve this controversy. Under such circumstances, there is no justification whatsoever for awarding appellees attorneys' fees.

This Court has often ruled that attorneys' fees are to be awarded only in exceptional circumstances, where the action of one party is completely malicious, vexatious and improper.

**THE FINDINGS OF FACT ENTERED HEREIN BY THE  
DISTRICT COURT ARE CLEARLY ERRONEOUS.**

It is submitted that the findings made and entered by the District Court are clearly erroneous. The prior sections of this brief, wherein the character of the Reading invention and the state of the prior art are discussed, establish that the District Court's finding with respect to validity of the Reading patent is clearly erroneous. We refer the Court to the prior sections of this brief which we believe establish the following:

1. The Reading invention did not measure up to the standard of invention as it is written into the Constitution and applied by the Supreme Court and by this Court.

2. The claims of the Reading patent are invalid in that they do not particularly point out and distinctly claim an identifiable invention as required by the Statute.

3. The Reading claims cover nothing more than a description of the function of an apparatus.

4. The Reading process merely follows the teachings of the prior art.

In addition, the District Court in making its findings completely overlooked the state of the art at the time Reading filed his application for Letters Patent which resulted in the issuance of the patent in suit. For example, Finding IV (R. 55) would lead one to believe that the only method of applying rubber cement to a tire carcass, at the time Reading filed his application for Letters Patent, was by brushing the rubber cement on the tire, resulting in a heavy wet coating, and that it was necessary thereafter to store the tire in a dust-free and fire-proof

room for a period of several hours or several days before the camelback or treadstock could be applied to the tire, and that vapor pockets and blow holes were common in retreaded tires at this time.

In Finding V (R. 57) made by the District Court, it is stated that the practice of applying rubber cement to a tire carcass, at the time Reading entered the field, created a serious health and fire hazard because of the excess of rubber cement that was applied to the tire by said brushing practice, and also that it was impossible to supply a retreaded tire to a customer within a short period of time or even the same day.

Both Findings IV and V completely ignore the evidence of this case which established that Cahill in the early part of January 1953 developed a spray method of applying rubber cement to tire carcasses which was substantially identical to the Reading patented method. This spray method of Cahill overcame all of the objections of the old prior brushing method recited in Findings IV and V. Said Cahill method was practiced continuously from February 7, 1953 until June 12, 1957, by Mr. Hartman who was given one of the Cahill spray devices on February 7, 1953. The record also establishes that Mr. Cahill sold many of his spray devices for use by tire retreaders in Virginia and North Carolina more than a year prior to the filing of the Reading application (R. 625-628).

These findings also ignore the fact that Mr. Reading, the patentee, used a spray process substantially identical to the one disclosed and claimed in the Reading patent from December 1951 until October 1953. This prior Read-

ing process overcame all of the disadvantages of the old paint brush method referred to in Findings IV and V. The record does not support Findings IV and V made by the District Court but rather supports Findings IV, V, VI, and VII submitted by appellant on objecting to appellees' proposed Findings set forth in this record at pages 42 to 44.

Finding VI (R. 58) is clearly erroneous because Mr. Reading did not work continuously to perfect and develop his method of spraying rubber cement from December 7, 1951 to December of 1953. Reading's patented process, in view of Cahill, Hartman and the Reading prior use, was not a safer, faster and cheaper method of preparing tires for retreading and did not revolutionize the prior art. Again, we submit that the District Court erred in making said Finding VI and ignored these prior uses of Cahill, Hartman and Reading. During the period from December 7, 1951 to December of 1953, the only experimentations that Mr. Reading made was on one passenger tire (R. 272-273 and on four truck tires (R. 274). This experimentation did not by any stretch of the imagination cover the purported change of the Reading patented process over the prior Reading process. It was not until October of 1953, when Mr. Reading picked up his spray pot and manually shook it (R. 275),<sup>7</sup> that the process of the patent in suit was allegedly developed. The record herein supports appellant's proposed Finding VI set forth at R. 44.

Again, the District Court erred in making Finding VII (R. 58). Certainly, the Reading process did not run con-

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<sup>7</sup>Shaking the pot in this manner was nothing more than the old step of agitation taught by many of the prior art patents.



trary to the Cahill and Hartman prior uses or the Reading prior use as said finding states. The Reading patented process is substantially identical to these prior uses. It is also substantially identical to the normal spray method that would result from the use, by one skilled in the art, of the Shelburne and Gradolph devices. With respect to the prior art teachings, it is submitted that appellant's proposed Findings IV, V, VI and VII (R. 42-44) more clearly set forth the facts as established by this record.

Finding VIII (R. 59) as made by the District Court is in error because it infers that Reading was the first to introduce air in a fluid (cement in the case of Reading) to form a dispersion of gas under pressure in a fluid. The District Court ignored the many patents of the prior art, particularly the patents to Shelburne, Gradolph, McLean et al. and McIntosh, which disclose the introduction of air into a fluid in a spray device. This particular finding is much broader than the disclosure of the Reading patent because it states that the said dispersion of gas is created "by bubbling air into the cement or otherwise dispersing the air therein as by agitation, mixing, beating or the like,". The only disclosure in the Reading patent is that Reading forms an emulsion of air and cement by dispersing gas into the cement at a high initial pressure and then reduces said pressure prior to the application pressure for spraying the emulsion of air and gas.

We have no quarrel with the use of the word "emulsion" in the Reading patent. However, we do contend that for a proper understanding of this word, as used in the claims of the Reading patent, one must refer to the specification of said patent and limit the claims by the disclosure of said specification.

Finding IX (R. 59) is in error in that this finding also ignores the prior uses of Cahill, Hartman and Reading. Mr. Cahill testified (R. 647) that there was no fire or dust hazard in the use of his method. Mr. Reading testified (R. 356) that cobwebbing could be corrected by thinning the cement. This, of course, is well known to those skilled in the art.

Finding X (R. 61) is in error because it is submitted that the Reading process is merely a description of the function of the Reading apparatus. As a matter of fact, the only description of the Reading process, contained in the Reading patent, is the describing of the function of the apparatus disclosed in said patent. We believe this subject matter is clearly and fully described in a prior portion of this brief found at pages 36-41.

The District Court Finding XI (R. 61) is also in error, particularly in that it states that the presumption of validity of the patent in suit is unaffected by the prior art. It is submitted that the best prior art was not before the Patent Office during the prosecution of the Reading application. In particular, the prior use and sale by Cahill and the prior uses of Hartman and Reading were not considered by the Patent Office, nor were the prior patents to Shelburne, Gradolph or McLean et al. considered by the Patent Office. All of this prior art, not considered by the Patent Office, anticipates the Reading invention.

Finding of Fact XII (R. 61) is in error and we refer the Court to pages 57-66 of this brief wherein the question of infringement is fully discussed. It is submitted that the process resulting from the use of appellant's device does not come within the disclosure and claims of the Reading patent.

Finding XIII (R. 62) stating that the Reading patent and the claims thereof are valid is, we contend, clearly in error.

Again, Finding of Fact XIV (R. 62) is in error in that the actions of appellees in the widespread notification of appellant and its customers of infringement by letter and by advertisement certainly constituted unfair competition.

Finally, Finding XV (R. 62) of the District Court is in error because there was no bad faith on the part of appellant in its acts of manufacturing and selling an old well-known spray device for use in spraying rubber cement on a tire carcass, another old and established step in tire retreading, and the District Court's finding of bad faith is completely unsupported by this record.

It is difficult to understand, on the basis of the record of this case, how the District Court made the findings it entered. To make these findings was to ignore the evidence. We submit that all of the findings made and entered by the District Court, respecting validity, infringement, bad faith and unfair competition, are clearly erroneous and that the decision of the District Court should therefore be reversed.

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**APPELLEES, BY WHOLESALE NOTIFICATION OF INFRINGEMENT OF APPELLANT'S CUSTOMERS WAS GUILTY OF UNFAIR COMPETITION.**

The appellees are guilty of unfair competition in that they promiscuously and recklessly sent letter notices of infringement to seventy-eight distributors and jobbers of tire retreading equipment (R. 602), many of whom were customers of appellant (R. 603), and then after the mailing

of these notices, they published a notice in a trade journal threatening every distributor, jobber and user of spray equipment with patent infringement (R. 231). After the sending of the letters and the publication of the notice in the trade journal, appellees sat back and did nothing with respect to the alleged infringement of their patent. This resulted in inquiries by appellant's customers with respect to the alleged infringement (R. 244), and resulted in the decline of appellant's business to such an extent that it was necessary for appellant to bring this declaratory judgment action to save its business (R. 247).

Such action on the part of appellees has often been characterized as unfair. In the case of *United States v. Patterson et al.*, 205 F. 292, 299, the Court said:

“ \* \* \* A patentee may properly warn the offending competing manufacturer, and may call attention to his patent and his claim of infringement; but when he threatens suit and does not bring it, or engages in acts of unfair competition, a court of equity will say to him: ,

‘Hold your hand; if you really have a patent, if the competitive concerns of which you complain are really infringing your patent, take the method the patent law has given you of establishing your monopoly by excluding your competitors, by enjoining them or seeking damages in the courts of the United States; otherwise, you interfere with your competitors’ business at your peril.’ ”

Also, in the case of *Dittgen v. Racine Paper Goods Co.*, 164 F. 85, 89, the Court said:

“It is the settled policy of the courts to restrain the illicit use of letters patent to maliciously injure the trade of competitors, whether the methods chosen



are a multiplicity of suits brought against users to inspire terror and divert the trade (Commercial Acetylene Co. v. Avery Co. [C. C.] 152 Fed. 642), or circulars maliciously and persistently distributed among the trade threatening suit against all users of the alleged infringement, not for the legitimate purpose of giving notice of the patentee's claims, but to terrify the customers of the alleged infringer.

\* \* \*”

In the recent case of *Beacon Theatres v. Westover*, 252 F. 2d 864, 873, this Court recognized the damage that can result from the threatening of customers, where it said:

“\* \* \* Such threats carry with them the implication that the distributors also may have to defend treble damage suits.”

\* \* \* \* \*

“\* \* \* Consistently with the allegations of the complaint defendant, unless enjoined, could go on indefinitely threatening the distributors and the plaintiff with future suits; and as long as the threats worked, defendant would have its way and the business of the plaintiff would be seriously limited.”

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### CONCLUSION.

We respectfully submit that this Court should find the patent in suit and the claims thereof totally invalid upon each of the following grounds:

- a. That the patent does not disclose a patentable invention.
- b. That it required only mechanical skill to produce the process claimed in the patent.
- c. That the patent is anticipated by the prior art.



d. That the patent is invalid because of prior public use.

e. That the claims of said patent in suit define nothing more than the function of a machine.

f. That the claims of the patent in suit do not particularly point out and distinctly claim an identifiable invention as required by 35 U.S.C. Section 112.

We further respectfully submit that this Court should find that appellant did not infringe claims of the patent in suit.

It is further submitted that the District Court was in error in awarding attorneys' fees to appellees.

It is further respectfully submitted that the District Court's Findings of Fact and Conclusions of Law, that the patent in suit involved invention and was infringed by the appellant, are in error and that the portion of the judgment of the District Court judging said patent valid and infringed should be reversed, as should that portion awarding appellees attorneys' fees.

Dated, San Francisco, California,  
September 3, 1958.

MELLIN, HANSCOM & HURSH,  
By JACK E. HURSH,  
*Attorneys for Appellant.*

**(Appendix Follows.)**



## **Appendix.**



## Appendix

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### Appellant's Exhibits:

<u>Exhibit Number</u>	<u>Identified</u>	<u>Offered</u>	<u>Received</u>	<u>Rejected</u>
1	73	73	73	
2	73	73	74	
3	74	74	74	
4	74	75	75	
5	75-76	76	76	
6	76-77			
7	93	94	94	
8	96	96	96	
9	147	188	188	
10	147	188	188	
11	147	188	188	
12	147	188	188	
13	147	188	188	
14	147	188	188	
15	147	188	188	
16	147	188	188	
17	206	210	210	
18	211	212	212	
19	245	485	485	
20	249	250	250	
21	249	250	250	
22	249	250	250	
23	384	384	384	
24	490	499	499	
25	500	500	501	



**Appellee's Exhibits:**

<b>Exhibit Number</b>	<b>Identified</b>	<b>Offered</b>	<b>Received</b>	<b>Rejected</b>
A	Prior to testimony			
B	Prior to testimony	138-139	139	
C	Prior to testimony	298	299	
D	Prior to testimony	307	307	
E	Prior to testimony	310	310	
F	Prior to testimony	239	239	
G	Prior to testimony	318	318	
H	Prior to testimony	310	310	
I	Prior to testimony	310	311	
J	Prior to testimony	305	306	
K	250			
K-1	250			
L	250	324	324	
M	147	147	147	
N	Prior to testimony			
O	Prior to testimony			
P	Prior to testimony	239	239	
Q	147	468	468	
R	Prior to testimony			
S	Prior to testimony	266	266	
T	71	318	318	
U	71	192	192	
V	233	234	234	
W	233	234	234	
X	250	303	305	
Y	265	267	267	
Z	414	416	417	
AA	414	416	418	
AB	459	459	459	
AC	479	479	480	
AD	483	483	483	
AE	485	485	485	
AF	497	498	498	